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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPELLANT: Lussier

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TITLE: *Chassis Construction for an Article of Footwear*

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BRIEF ON APPEAL UNDER 37 C.F.R. § 1.192

This Appeal Brief is submitted in support of the appeal from the Primary Examiner's March 18, 2003, rejection of claims 1, 4-23, 26-31, and 35-39 in the above-identified application. Appellant submits this Appeal Brief in triplicate in furtherance of the Notice of Appeal filed June 20, 2003. Appellant encloses a check for \$430.00 for the fee for filing this Appeal Brief (\$320.00), and the fee for a one-month extension of time (\$110.00). By the enclosed Petition for a One-Month Extension of Time under 37 C.F.R. § 1.17(a), the deadline for submission of this appeal brief is extended until Saturday, September 20, 2003, and, by 37 C.F.R. § 1.7(a), is further extended until Monday, September 22, 2003. The Director is hereby authorized to charge any additional fees that may be due, for further extensions of time or any other purpose associated with this submission, or credit any overpayment, to Appellant's undersigned counsel's deposit account number 20-0531 with reference to docket number ADI-022. A duplicate copy of this authorization is enclosed for that purpose.

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REAL PARTY IN INTEREST

The real party in interest is adidas International, B.V., the assignee, pursuant to an assignment recorded in the records of the U.S. Patent and Trademark Office February 12, 2001, at Reel 011517, beginning at Frame 0207.

RELATED APPEALS AND INTERFERENCES

The Appellant, the Appellant's legal representative, and assignee are unaware of any other appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1, 4-23, 26-31, and 35-39 have been rejected. Claims 2, 3, 24, 25, and 32-34 have been cancelled. No claims have been allowed. This appeal involves claims 1, 4-23, 26-31, and 35-39.

STATUS OF AMENDMENTS

No amendment under 37 C.F.R. § 1.111 has been filed in response to the Office Action dated March 18, 2003.

SUMMARY OF INVENTION

The present invention, as set forth in Appellant's specification, relates to a chassis construction for an article of footwear, namely, a shoe used in the sports of football or soccer. Specification, p. 1, ll. 1-5¹. The chassis construction provides comfort, flexibility, support, and power transfer by varying the configuration, thickness, or material of the chassis. *Id.* In contrast, conventional sport shoes attempt to offer these features by varying the configuration of the shoe outsole. P. 1, ll. 13-19. The chassis construction provided by Appellant's invention provides these features with less cost and manufacturing difficulty. *Id.*

¹ Citations to page and line numbers refer to the Specification as filed.

Claim 1 is directed to a single piece generally planar polymeric chassis (Figure 1A, RD² 2; p. 6, ll. 4-5) for installation in an article of footwear. The chassis includes a medial side, a lateral side, a forefoot portion, a midfoot portion, and a rearfoot portion. Figure 1A, RD 4, 6, 8; p. 6, ll. 5-6; Figure 2A, RD 104, 106, 108; Figure 4, RD 304, 306, 308. The forefoot portion includes a plurality of elongated elements that extend from the lateral side to the medial side, and from the midfoot portion into substantially an entire length of the forefoot portion. P. 2, ll. 18-19. There is at least one space between the elongated elements extending from a forwardmost extent of the forefoot portion and terminating in the midfoot portion. Figure 1A, RD 14; p. 6, ll. 10-13; Figure 2A, RD 114; Figure 4; RD 314. The rearfoot portion includes at least one elongated element that extends from the midfoot portion into substantially an entire length of a heel portion of the chassis. P. 2, ll. 16-17.

Claim 4 is directed to the chassis of claim 1 wherein the forefoot portion comprises three elongated elements. Figure 1A, RD 10; p. 6, ll. 9-10; Figure 2A, RD 110; p. 8, ll. 11-12; Figure 3A, RD 210; p. 10, ll. 23-24; Figure 4, RD 310; p. 13, ll. 9-10.

Claim 5 is directed to the chassis of claim 1 wherein the at least one elongated element comprises at least one indentation along a width of the chassis. Figure 2A, RD 122; p. 8, ll. 11-12; Figure 3A, RD 222; p. 10, ll. 23-24; Amendment and Response, Aug. 29, 2001, p. 10.

Claim 6 is directed to the chassis of claim 1 wherein the rearfoot portion comprises two elongated elements. P. 3, ll. 4-5.

Claim 7 is directed to the chassis of claim 4 wherein the forefoot portion elongated elements are disposed adjacent one another. P. 6, ll. 10-11; p. 13, ll. 12-13.

Claim 8 is directed to the chassis of claim 6 wherein the rearfoot portion elongated elements are disposed adjacent one another. P. 13, ll. 12-13.

Claim 9 is directed to the chassis of claim 1 wherein the rearfoot portion comprises two elements defining an opening therebetween. P. 3, ll. 4-5.

² Citations to the figures include the reference designator ("RD") where applicable, and refer to the figures filed on January 7, 2003. According to the Office Action dated March 18, 2003, the Examiner accepted these drawings.

Claim 10 is directed to the chassis of claim 9 wherein the opening is in a form of a chevron. P. 6, ll. 15-16.

Claim 11 is directed to the chassis of claim 10 wherein the chevron opens to one of the medial side or the lateral side of the chassis. P. 6, ll. 17-18.

Claim 12 is directed to the chassis of claim 1 wherein a thickness of a first portion of the chassis is different than a thickness of a second portion of the chassis. P. 4, ll. 15-17.

Claim 13 is directed to the chassis of claim 12, wherein the first portion of the chassis comprises the forefoot portion and the second portion comprises the rearfoot portion. P. 4, ll. 17-18.

Claim 14 is directed to the chassis of claim 12, wherein the first portion of the chassis comprises a first elongated element and the second portion comprises a second elongated element. P. 4, ll. 19-20.

Claim 15 is directed to the chassis of claim 12, wherein the first portion of the chassis comprises the midfoot portion and the second portion comprises the forefoot portion. P. 4, ll. 17-19.

Claim 16 is directed to the chassis of claim 12, wherein the chassis comprises more than two portions, each comprising a different thickness. P. 4, ll. 20-22.

Claim 17 is directed to the chassis of claim 1, wherein a first portion of the chassis comprises a material with properties different than a material of a second portion of the chassis. P. 4, ll. 24-26.

Claim 18 is directed to the chassis of claim 17, wherein the chassis comprises more than two portions, each comprising different material properties. P. 4, ll. 26-28.

Claim 19 is directed to the chassis of claim 1, wherein the chassis further comprises a common midfoot portion. P. 6, ll. 5-6.

Claim 20 is directed to a single piece generally planar polymeric chassis (Figure 1A, RD 2; p. 6, ll. 4-5) for installation in an article of footwear. The chassis includes a plurality of

elongated elements that extend from a lateral side to a medial side of the chassis and extend substantially along an entire length from a heel portion of the chassis to a toe portion of the chassis. P. 3, ll. 7-10. Each elongated element has a midfoot portion, a forefoot portion, and a rearfoot portion. *Id.* There is at least one space between the plurality of elongated elements that extends from their forwardmost extent and terminates in the midfoot portion. Figure 1A, RD 14; p. 3, ll. 11-12; Figure 2A, RD 114; Figure 3A, RD 214.

Claim 21 is directed to the chassis of claim 20, wherein the elongated elements are disposed adjacent one another. P. 6, ll. 10-11; p. 13, ll. 12-13.

Claim 22 is directed to the chassis of claim 1, further comprising at least one lug extending from a bottom side of the chassis. P. 8, ll. 18-22.

Claim 23 is directed to the chassis of claim 20, further comprising at least one lug extending from a bottom side of the chassis. *Id.*

Claim 26 is directed to an article of footwear that includes a sole with at least one cleat. P. 3, ll. 15-16; p. 4, ll. 11-13. The sole includes a generally planar polymeric chassis (Figure 1A, RD 2; p. 6, ll. 4-5), wherein a forefoot portion of the chassis has a lateral side and a medial side. Figure 1A, RD 6; Figure 2A, RD 106; Figure 3, RD 206; Figure 4, RD 306. The lateral and medial sides are proximate to the corresponding lateral and medial sides of the article of footwear. *Id.* The chassis extends substantially along an entire length of heel and toe portions of the article of footwear. P. 2, ll. 18-19. The cleat is proximate to at least one of the lateral and medial sides of the article of footwear. Figure 3A, RD 232; p. 10, ll. 19-20.

Claim 27 is directed to the article of footwear of claim 26, wherein the chassis includes a midfoot portion, a forefoot portion that includes at least one elongated element extending toward a toe portion from the midfoot portion, and a rearfoot portion that includes at least one elongated element extending toward a heel portion from the midfoot portion. Figure 3A.

Claim 28 is directed to the article of footwear of claim 26, wherein the chassis includes a plurality of elongated elements extending generally from a heel portion to a toe portion. Each elongated element has a midfoot portion, a forefoot portion, and a rearfoot portion. *Id.*

Claim 29 is directed to the article of footwear of claim 26, wherein the sole is an outsole. P. 4, ll. 9-10.

Claim 30 is directed to the article of footwear of claim 26, wherein the chassis further comprises at least one lug extending from a bottom side of the chassis. Figure 3A, RD 230; p. 10, ll. 18-19.

Claim 31 is directed to the article of footwear of claim 30, wherein the at least one lug projects into the cleat. Figure 3A, RD 230, 232; p. 10, ll. 19-20.

Claim 35 is directed to the article of footwear of claim 26 wherein the polymeric chassis is integrally formed with a skin. Figure 3A, RD 201; p. 11, ll. 14-15.

Claim 36 is directed to the article of footwear of claim 35 further comprising an externally visible intermediate layer of material between the integrally formed chassis and skin. Figure 3B, RD 203, p. 12, ll. 8-11; 14-16.

Claim 37 is directed to the article of footwear of claim 36, wherein the intermediate layer of material is a film. P. 12, ll. 8-11.

Claim 38 is directed to the article of footwear of claim 37, wherein the film comprises one of a design, a color, and a combination of a design and a color. P. 12, ll. 14-15.

Claim 39 is directed to a generally planar polymeric chassis (Figure 4, RD 302; p. 13, ll. 9-10) for installation in an article of footwear. The chassis includes at least three elongated elements with generally nonlinear spaces between them. Figure 4, RD 310, 314; p. 13, ll. 9-10; 12-13. The elongated elements extend from a lateral side to a medial side of the chassis, and extend substantially along an entire length of the chassis from a heel portion of the chassis to a toe portion of the chassis. Figure 4, p. 13, ll. 11-12. Each elongated element has a midfoot portion, a forefoot portion, and a rearfoot portion. *Id.*

ISSUES

1. Whether claims 26, 29, and 30 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Crowley (U.S. Pat. No. 4,393,604).

2. Whether claims 1, 4-9, 19-21, 26-29, and 35 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Tong et al. (U.S. Pat. No. 5,185,943).
3. Whether claims 26 and 29-31 are unpatentable under 35 U.S.C. § 103(a) over Trolle (U.S. Pat. No. 1,141,889) in view of Barma et al. (U.S. Pat. No. 5,546,680).
4. Whether claims 1, 4, 6-10, 19, and 26-29 are unpatentable under 35 U.S.C. § 103(a) over Lorenzi et al. (U.S. Pat. No. 1,684,676).
5. Whether claims 1, 5, 6, 8-10, 12-23, and 39 are unpatentable under 35 U.S.C. § 103(a) over Giese et al. (U.S. Pat. No. 5,572,805) in view of Tong et al. (U.S. Pat. No. 5,185,943) or Brown (U.S. Pat. No. D446,917) and Thomas (U.S. Pat. No. 444,735).
6. Whether claim 11 is unpatentable under 35 U.S.C. § 103(a) over Giese et al. (U.S. Pat. No. 5,572,805) in view of Tong et al. (U.S. Pat. No. 5,185,943) or Brown (U.S. Pat. No. D446,917) and Thomas (U.S. Pat. No. 444,735), and further in view of Kendall (U.S. Pat. No. 5,713,143).
7. Whether claims 26-30 and 35-38 are unpatentable under 35 U.S.C. § 103(a) over Giese et al. (U.S. Pat. No. 5,572,805) in view of Tong et al. (U.S. Pat. No. 5,185,943) or Brown (U.S. Pat. No. D446,917) and Thomas (U.S. Pat. No. 444,735), and further in view of Crowley (U.S. Pat. No. 4,393,604).
8. Whether claims 30 and 31 are unpatentable under 35 U.S.C. § 103(a) over Giese et al. (U.S. Pat. No. 5,572,805) in view of Tong et al. (U.S. Pat. No. 5,185,943) or Brown (U.S. Pat. No. D446,917) and Thomas (U.S. Pat. No. 444,735), further in view of Crowley (U.S. Pat. No. 4,393,604), and further in view of Cameron (U.S. Pat. No. 3,739,497) or Barre (U.S. Pat. No. 5,473,827).

GROUPING OF CLAIMS

Appellant respectfully submits that claims 1, 4-23, 26-31, and 35-39 do not stand or fall together and are separately patentable for at least the reasons set forth below.

ARGUMENT

I. Claims 26, 29, and 30 constitute novel subject matter and are patentable over Crowley (U.S. Pat. No. 4,393,604).

A. Prima Facie Anticipation

To establish a prima facie case of anticipation, the Examiner must show, *inter alia*, that the reference teaches or enables each of the claimed elements. *W.L. Gore & Assocs. v. Garlock, Inc.*, 220 U.S.P.Q. (BNA) 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, the reference must show each of the claimed elements as arranged in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 U.S.P.Q. (BNA) 481, 485 (Fed. Cir. 1984).

B. The cited reference does not anticipate claims 26, 29, and 30 and render them unpatentable under 35 U.S.C. § 102(b).

In the Office Action mailed on March 18, 2003, the Examiner rejected claims 26, 29, and 30 under 35 U.S.C. § 102(b) as being anticipated by Crowley (U.S. Pat. No. 4,393,604). Office Action, p. 2.

1. U.S. Patent No. 4,393,604 to Crowley (issued July 19, 1983).

Crowley discloses an outsole 10 for an athletic shoe that includes nonmetallic cleats or studs 14, 16, 18, 20, 22, 24, 26, 28, 30, 32. Crowley, col. 1, ll. 31-34. The outsole 10 includes an outsole member 12. Col. 2, ll. 9-10. The studs and the outsole member 12 may be integrally molded. Col. 2, ll. 10-12. Certain areas of the outsole 10 may be eliminated or, in the other extreme, thickened to adjust outsole stiffness. Col. 4, ll. 2-4.

2. The cited reference does not render claim 26 unpatentable under 35 U.S.C. § 102(b).

Claim 26 is directed to an article of footwear that includes a sole with at least one cleat that is proximate to one or both of the lateral and medial sides of the article of footwear, and a

generally planar polymeric chassis that extends substantially along an entire length of the heel and toe portions of the article of footwear.

The Office Action states that claim 26 is “clearly anticipated by Crowley.” Office Action, p. 2. Since the Office Action does not provide an explanation of the pertinence of the reference, Appellant is unable to discern the Examiner’s rationale regarding Crowley. Nevertheless, claim 26 is distinguishable from Crowley at least because Crowley fails to teach or enable Appellant’s claimed chassis. Crowley discloses an outsole, which is distinguishable from Appellant’s chassis. As described in the Specification, an embodiment of the invention replaces a conventional outsole with a soft outsole, and adds the chassis to achieve the required stiffness. Specification, p. 1, ll. 13-14; p. 2, ll. 7-10. In other words, Appellant’s claimed chassis is distinct from, and in addition to, any outsole, and Crowley fails to teach or enable at least this element. Accordingly, a prima facie case of anticipation has not been established with respect to claim 26. *W.L. Gore & Assocs. v. Garlock*.

Appellant respectfully submits that at least the chassis limitation of claim 26 clearly and patentably distinguishes the claimed invention over Crowley, that claim 26 is novel in view of this reference, and that claim 26 is separately patentable from the remaining claims.

3. The cited reference does not render claim 29 unpatentable under 35 U.S.C. § 102(b).

Claim 29 is directed to the article of footwear of claim 26, wherein the sole is an outsole. P. 4, ll. 9-10. Because claim 29 depends from claim 26 and includes the limitations thereof, claim 29 requires that the claimed article of footwear include both a chassis and an outsole. This further illustrates that Appellant’s chassis is distinguishable from an outsole, as discussed above regarding claim 26, otherwise claim 29 would be superfluous.

Although Crowley discloses an outsole, Crowley neither teaches nor enables a structure with at least a chassis and an outsole. Accordingly, a prima facie case of anticipation has not been established with respect to claim 29. *W.L. Gore & Assocs. v. Garlock*.

In view of the above, Appellant respectfully submits that claim 29 clearly and patentably distinguishes the claimed invention over Crowley, that claim 29 is novel in view of this reference, and that claim 29 is separately patentable from the remaining claims.

4. The cited reference does not render claim 30 unpatentable under 35 U.S.C. § 102(b).

Claim 30 is directed to the article of footwear of claim 26, wherein the chassis further comprises at least one lug extending from a bottom side of the chassis. Figure 3A, RD 230; p. 10, ll. 18-19. Because claim 30 depends from claim 26 and includes the limitations thereof, claim 30 requires that the article of footwear include both a chassis and a lug extending from the chassis.

Crowley neither teaches nor enables a structure with at least a chassis having a lug extending therefrom. As discussed above, Crowley's teachings relate to an outsole. Crowley discloses studs or cleats extending from the outsole, not a chassis. *See, e.g.*, col. 2, ll. 9-12. Accordingly, a prima facie case of anticipation has not been established with respect to claim 30. *W.L. Gore & Assocs. v. Garlock*.

In view of the above, Appellant respectfully submits that claim 30 clearly and patentably distinguishes the claimed invention over Crowley, that claim 30 is novel in view of this reference, and that claim 30 is separately patentable from the remaining claims.

II. Claims 1, 4-9, 19-21, 26-29, and 35 constitute novel subject matter and are patentable over Tong et al. (U.S. Pat. No. 5,185,943).

A. The cited reference does not anticipate claims 1, 4-9, 19-21, 26-29, and 35 and render them unpatentable under 35 U.S.C. § 102(b).

In the Office Action mailed on March 18, 2003, the Examiner rejected 1, 4-9, 19-21, 26-29, and 35 under 35 U.S.C. § 102(b) as being anticipated by Tong et al. (U.S. Pat. No. 5,185,943). Office Action, p. 2.

1. U.S. Patent No. 5,185,943 to Tong et al. (issued Feb. 16, 1993).

Tong et al. discloses an insert member 56, 90, 120 for a sole 24. Tong et al., col. 6, ll. 3-7; col. 8, ll. 22; col. 9, l. 10. The sole 24 includes an outsole 26 that, in the heel region 30, includes downwardly extending lugs 32-46. Col. 5, ll. 8-10. The insert member 56 includes extensions 60-72 in positions that correspond to those of the lugs 32-46. Col. 7, ll. 44-47. Tong et al. Figure 16 offers a plan view of the insert member 120. Figure 17 provides a side view of the insert member 120 depicted in Figure 16.

2. The cited reference does not render claim 1 unpatentable under 35 U.S.C. § 102(b).

Claim 1 is directed to a single piece polymeric chassis for an article of footwear. The chassis includes elongated elements extending into the forefoot and heel portions. One element of the claim requires that the chassis be generally planar, as described in the Specification (p. 8, l. 1) and depicted in the drawings (*see, e.g.*, Figures 1B, 1C, 1D, 2B, 2C, and 2D). The generally planar characteristic includes simple contours, visible in cross-sectional views of Appellant's chassis, to better conform to the shape of the foot. *Id.*

The Office Action states that, in reference to Tong et al. Figure 16, Tong et al. shows a "generally planar chassis 120." Office Action, p. 2. This statement mischaracterizes Tong et al. because (1) it is in direct opposition to the explicit teachings of the reference, where the insert member 120 is described as having "an undulating or sinusoidal shape in cross section" (col. 9, ll. 27-29), and (2) it relies on Tong et al. Figure 16, which is a "plan view" of the insert 120 that does not depict the cross-sectional perspective relevant to Appellant's claim 1. The terms "undulating," meaning having a wavelike appearance, and "sinusoidal," meaning having a succession of waves or curves, describe a profile that is contrary to the generally planar characteristic of Appellant's chassis. Further, the "undulating or sinusoidal shape" of the Tong et al. insert 120 is shown clearly in Figure 17, which depicts a proper cross-sectional perspective for comparison with Appellant's claimed invention. Comparing Tong et al. Figure 17 with, for example, Appellant's Figures 2B, 2C, and 2D, shows the striking difference therebetween. Accordingly, Tong et al. fails to teach or enable at least the generally planar element, so a prima

facie case of anticipation has not been established with respect to claim 1. *W.L. Gore & Assocs. v. Garlock*.

In view of the above, Appellant respectfully submits that at least the generally planar chassis limitation of claim 1 clearly and patentably distinguishes the claimed invention over Tong et al., that claim 1 is novel in view of this reference, and that claim 1 is separately patentable from the remaining claims.

3. The cited reference does not render claim 4 unpatentable under 35 U.S.C. § 102(b).

Claim 4 is directed to the chassis of claim 1 wherein the forefoot portion comprises three elongated elements. Figure 1A, RD 10; p. 6, ll. 9-10; Figure 2A, RD 110; p.8, ll. 11-12; Figure 3A, RD 210; p. 10, ll. 23-24; Figure 4, RD 310; p. 13, ll. 9-10. Because claim 4 depends from claim 1 and includes the limitations thereof, claim 4 requires that the article of footwear include both the three elongated elements in the forefoot portion and a generally planar chassis.

Although Tong et al. discloses a plurality of fingers 122 in an extending portion 124 of the insert 120 (col. 9, ll. 23-26), Tong et al. neither teaches nor enables a structure with at least three elongated elements in the forefoot and a generally planar chassis. Accordingly, a prima facie case of anticipation has not been established with respect to claim 4. *W.L. Gore & Assocs. v. Garlock*.

In view of the above, Appellant respectfully submits that claim 4 clearly and patentably distinguishes the claimed invention over Tong et al., that claim 4 is novel in view of this reference, and that claim 4 is separately patentable from the remaining claims.

4. The cited reference does not render claim 5 unpatentable under 35 U.S.C. § 102(b).

Claim 5 is directed to the chassis of claim 1 wherein an elongated element has at least one indentation along a width of the chassis. Figure 2A, RD 122; p. 8, ll. 11-12; Figure 3A, RD 222; p. 10, ll. 23-24; Amendment and Response, Aug. 29, 2001, p. 10. The indentation, or “fold line,” increases the flexibility of the chassis. P. 8, ll. 12-17; p. 10, ll. 23-24. Because claim 5 depends

from claim 1 and includes the limitations thereof, claim 5 requires that the article of footwear include both the indentation and a generally planar chassis.

Tong et al. neither teaches nor enables a chassis that includes indentations or fold lines. Rather, to increase flexibility, Tong et al. relies on openings in the insert. *See, e.g.*, col. 6, ll. 63-64. Accordingly, with respect to the indentation element, and the generally planar element discussed above, a prima facie case of anticipation has not been established with respect to claim 5. *W.L. Gore & Assocs. v. Garlock*.

In view of the above, Appellant respectfully submits that claim 5 clearly and patentably distinguishes the claimed invention over Tong et al., that claim 5 is novel in view of this reference, and that claim 5 is separately patentable from the remaining claims.

5. The cited reference does not render claim 6 unpatentable under 35 U.S.C. § 102(b).

Claim 6 is directed to the chassis of claim 1 wherein the rearfoot portion has two elongated elements. P. 3, ll. 4-5. Because claim 6 depends from claim 1 and includes the limitations thereof, claim 6 requires that the article of footwear include both the two elongated elements in the rearfoot portion and a generally planar chassis.

Tong et al. discloses insert extensions 92 in the rearfoot portion of the insert member 90. Figures 9, 16 (undesignated). Nevertheless, Tong et al. neither teaches nor enables a structure with at least two elongated elements in the rearfoot and a generally planar chassis. Accordingly, a prima facie case of anticipation has not been established with respect to claim 6. *W.L. Gore & Assocs. v. Garlock*.

In view of the above, Appellant respectfully submits that claim 6 clearly and patentably distinguishes the claimed invention over Tong et al., that claim 6 is novel in view of this reference, and that claim 6 is separately patentable from the remaining claims.

6. The cited reference does not render claim 7 unpatentable under 35 U.S.C. § 102(b).

Claim 7 is directed to the chassis of claim 4 wherein the forefoot portion elongated elements are disposed adjacent one another. P. 6, ll. 10-11; p. 13, ll. 12-13. Because claim 7 depends directly from claim 4 and indirectly from claim 1, and includes all of the limitations of both, claim 7 requires that the article of footwear include a generally planar chassis with three elongated elements that are adjacent to one another in the forefoot portion.

Although Tong et al. discloses a plurality of fingers 122 in an extending portion 124 of the insert 120 (col. 9, ll. 23-26), Tong et al. neither teaches nor enables a structure with at least three, adjacent elongated elements in the forefoot and a generally planar chassis. Accordingly, a prima facie case of anticipation has not been established with respect to claim 7. *W.L. Gore & Assocs. v. Garlock*.

In view of the above, Appellant respectfully submits that claim 7 clearly and patentably distinguishes the claimed invention over Tong et al., that claim 7 is novel in view of this reference, and that claim 7 is separately patentable from the remaining claims.

7. The cited reference does not render claim 8 unpatentable under 35 U.S.C. § 102(b).

Claim 8 is directed to the chassis of claim 6 wherein the rearfoot portion elongated elements are disposed adjacent one another. P. 13, ll. 12-13. Because claim 8 depends directly from claim 6 and indirectly from claim 1, and includes all of the limitations of both, claim 8 requires that the article of footwear include a generally planar chassis with two elongated elements that are adjacent to one another in the rearfoot portion.

Tong et al. discloses insert extensions 92 in the rearfoot portion of the insert member 90. Figures 9, 16 (undesigned). Nevertheless, Tong et al. neither teaches nor enables a structure with at least two adjacent, elongated elements in the rearfoot and a generally planar chassis. Accordingly, a prima facie case of anticipation has not been established with respect to claim 8. *W.L. Gore & Assocs. v. Garlock*.

In view of the above, Appellant respectfully submits that claim 8 clearly and patentably distinguishes the claimed invention over Tong et al., that claim 8 is novel in view of this reference, and that claim 8 is separately patentable from the remaining claims.

8. The cited reference does not render claim 9 unpatentable under 35 U.S.C. § 102(b).

Claim 9 is directed to the chassis of claim 1 wherein the rearfoot portion has two elements that define an opening between them. P. 3, ll. 4-5. Because claim 9 depends from claim 1 and includes the limitations thereof, claim 9 requires that the article of footwear include both a generally planar chassis and two elongated elements in the rearfoot portion that define an opening.

Tong et al. discloses insert extensions 92 in the rearfoot portion of the insert member 90. Figures 9, 16 (undesignated). Nevertheless, Tong et al. neither teaches nor enables a structure with at least two elongated elements in the rearfoot that define an opening and a generally planar chassis. Accordingly, a prima facie case of anticipation has not been established with respect to claim 9. *W.L. Gore & Assocs. v. Garlock*.

In view of the above, Appellant respectfully submits that claim 9 clearly and patentably distinguishes the claimed invention over Tong et al., that claim 9 is novel in view of this reference, and that claim 9 is separately patentable from the remaining claims.

9. The cited reference does not render claim 19 unpatentable under 35 U.S.C. § 102(b).

Claim 19 is directed to the chassis of claim 1, wherein the chassis includes a common midfoot portion. P. 6, ll. 5-6. Because claim 19 depends from claim 1 and includes the limitations thereof, claim 19 requires that the article of footwear include both a generally planar chassis and a common midfoot portion.

Tong et al. does not specifically disclose a midfoot portion, and the Office Action does not specify where this feature appears in the reference. Nevertheless, Appellant notes that Tong et al. Figure 16 depicts a plan view of the insert 120 showing its heel-to-toe extent. For the

purpose of this appeal only, Appellant assumes that the undesignated portion of the insert 120 between the heel and toe areas may be considered a midfoot portion. Consequently, Tong et al. neither teaches nor enables a structure with at least a common midfoot portion and a generally planar chassis. Accordingly, a prima facie case of anticipation has not been established with respect to claim 19. *W.L. Gore & Assocs. v. Garlock*.

In view of the above, Appellant respectfully submits that claim 19 clearly and patentably distinguishes the claimed invention over Tong et al., that claim 19 is novel in view of this reference, and that claim 19 is separately patentable from the remaining claims.

10. The cited reference does not render claim 20 unpatentable under 35 U.S.C. § 102(b).

Claim 20 is directed to a single piece polymeric chassis for an article of footwear. One element of the claim requires that the chassis be generally planar. The generally planar characteristic includes simple contours, visible in cross-sectional views of Appellant's chassis, to better conform to the shape of the foot. *See, e.g.*, Figures 2B, 2C, 2D, 3B, 3C, 3D.

As discussed above in connection with claim 1, the "undulating or sinusoidal shape" of the Tong et al. insert member 120 fails to teach or enable at least Appellant's generally planar element. Since this element is also included in claim 20, a prima facie case of anticipation has not been established with respect to claim 20 as well. *W.L. Gore & Assocs. v. Garlock*.

Appellant respectfully submits that at least the generally planar limitation of claim 20 clearly and patentably distinguishes the claimed invention over Tong et al., that claim 20 is novel in view of this reference, and that claim 20 is separately patentable from the remaining claims.

11. The cited reference does not render claim 21 unpatentable under 35 U.S.C. § 102(b).

Claim 21 is directed to the chassis of claim 20, wherein the elongated elements are disposed adjacent one another. P. 6, ll. 10-11; p. 13, ll. 12-13. Because claim 21 depends from claim 20 and includes the limitations thereof, claim 21 requires that the article of footwear include a generally planar chassis with elongated elements that are adjacent to one another.

Although Tong et al. discloses a plurality of fingers 122 in an extending portion 124 of the insert 120 (col. 9, ll. 23-26), Tong et al. neither teaches nor enables a structure with at least adjacent elongated elements in the forefoot and a generally planar chassis. Accordingly, a prima facie case of anticipation has not been established with respect to claim 21. *W.L. Gore & Assocs. v. Garlock*.

In view of the above, Appellant respectfully submits that claim 21 clearly and patentably distinguishes the claimed invention over Tong et al., that claim 21 is novel in view of this reference, and that claim 21 is separately patentable from the remaining claims.

12. The cited reference does not render claim 26 unpatentable under 35 U.S.C. § 102(b).

Claim 26 is directed to an article of footwear that includes a sole with at least one cleat that is proximate to one or both of the lateral and medial sides of the article of footwear, and a generally planar polymeric chassis that extends substantially along an entire length of the heel and toe portions of the article of footwear.

Although Tong et al. discloses a plurality of lugs (i.e., cleats) 32-46 in the heel region 30 of the outsole 26 (col. 5, ll. 8-10), Tong et al. neither teaches nor enables a structure with at least lugs and a generally planar chassis. Accordingly, a prima facie case of anticipation has not been established with respect to claim 26. *W.L. Gore & Assocs. v. Garlock*.

Appellant respectfully submits that at least the generally planar limitation of claim 26 clearly and patentably distinguishes the claimed invention over Tong et al., that claim 26 is novel in view of this reference, and that claim 26 is separately patentable from the remaining claims.

13. The cited reference does not render claim 27 unpatentable under 35 U.S.C. § 102(b).

Claim 27 is directed to the article of footwear of claim 26, wherein the chassis includes an elongated element extending toward a toe portion from a midfoot portion, and an elongated element extending toward a heel portion from the midfoot portion. Figure 3A. Because claim 27

depends from claim 26 and includes the limitations thereof, claim 27 requires that the article of footwear include a generally planar chassis, a cleat, and elongated elements.

Tong et al. discloses a plurality of fingers 122 in an extending portion 124 of the insert 120 (col. 9, ll. 23-26) and insert extensions 92 in the rearfoot portion of the insert member 90. Figures 9, 16 (undesignated). Nevertheless, Tong et al. neither teaches nor enables a structure with at least lugs, elongated elements in the toe and heel portions, and a generally planar chassis. Accordingly, a prima facie case of anticipation has not been established with respect to claim 27. *W.L. Gore & Assocs. v. Garlock*.

In view of the above, Appellant respectfully submits that claim 27 clearly and patentably distinguishes the claimed invention over Tong et al., that claim 27 is novel in view of this reference, and that claim 27 is separately patentable from the remaining claims.

14. The cited reference does not render claim 28 unpatentable under 35 U.S.C. § 102(b).

Claim 28 is directed to the article of footwear of claim 26, wherein the chassis includes a plurality of elongated elements extending generally from a heel portion to a toe portion. Figure 3A. Because claim 28 depends from claim 26 and includes the limitations thereof, claim 28 requires that the article of footwear include a generally planar chassis, a cleat, and elongated elements.

Tong et al. discloses a plurality of fingers 122 in an extending portion 124 of the insert 120 (col. 9, ll. 23-26) and insert extensions 92 in the rearfoot portion of the insert member 90. Figures 9, 16 (undesignated). Nevertheless, Tong et al. neither teaches nor enables a structure with at least lugs, elongated elements extending from the heel portion to toe the portion, and a generally planar chassis. Accordingly, a prima facie case of anticipation has not been established with respect to claim 28. *W.L. Gore & Assocs. v. Garlock*.

In view of the above, Appellant respectfully submits that claim 28 clearly and patentably distinguishes the claimed invention over Tong et al., that claim 28 is novel in view of this reference, and that claim 28 is separately patentable from the remaining claims.

15. The cited reference does not render claim 29 unpatentable under 35 U.S.C. § 102(b).

Claim 29 is directed to the article of footwear of claim 26, wherein the sole is an outsole. P. 4, ll. 9-10. Because claim 29 depends from claim 26 and includes the limitations thereof, claim 29 requires that the article of footwear include a generally planar chassis, a cleat, and an outsole.

Although Tong et al. discloses an outsole 26 (col. 5, ll. 8-10) and a plurality of lugs (i.e., cleats) 32-46 (*Id.*), Tong et al. neither teaches nor enables a structure with at least these features and a generally planar chassis. Accordingly, a prima facie case of anticipation has not been established with respect to claim 29. *W.L. Gore & Assocs. v. Garlock*.

In view of the above, Appellant respectfully submits that claim 29 clearly and patentably distinguishes the claimed invention over Tong et al., that claim 29 is novel in view of this reference, and that claim 29 is separately patentable from the remaining claims.

16. The cited reference does not render claim 35 unpatentable under 35 U.S.C. § 102(b).

Claim 35 is directed to the article of footwear of claim 26 wherein the polymeric chassis is integrally formed with a skin. Figure 3A, RD 201; p. 11, ll. 14-15. Because claim 35 depends from claim 26 and includes the limitations thereof, claim 35 requires that the article of footwear include a generally planar chassis, a cleat, and a skin integral with the chassis.

As the Office Action states, Tong et al. discloses encapsulation of the insert member 90. Office Action, p. 2. Nevertheless, Tong et al. neither teaches nor enables a structure with at least this feature and a generally planar chassis. Accordingly, a prima facie case of anticipation has not been established with respect to claim 35. *W.L. Gore & Assocs. v. Garlock*.

In view of the above, Appellant respectfully submits that claim 35 clearly and patentably distinguishes the claimed invention over Tong et al., that claim 35 is novel in view of this reference, and that claim 35 is separately patentable from the remaining claims.

III. Claims 26 and 29-31 constitute nonobvious subject matter and are patentable over Trolle (U.S. Pat. No. 1,141,889) in view of Barma et al. (U.S. Pat. No. 5,546,680).

A. Prima Facie Obviousness

To establish a prima facie case of obviousness, the Examiner must show, *inter alia*, some reason, suggestion, or motivation from the prior art as a whole for the person of ordinary skill to have combined or modified the references to arrive at the claimed invention at the time the invention was made. An invention is nonobvious where one prior art reference teaches away from the combination with another prior art reference. *In re Rudko*, Civ. App. No. 98-1505, slip op. at 5-6 (Fed. Cir. May 14, 1999). A prior art reference may be said to teach away when a person of ordinary skill, on reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that the Appellant took. *In re Gurley*, 31 U.S.P.Q.2d (BNA) 1130, 1131 (Fed. Cir. 1994).

Further, an invention is nonobvious if the elements in the reference deal with problems different than those addressed by the claimed invention. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 U.S.P.Q. (BNA) 481, 488-89 (Fed. Cir. 1984).

Lastly, the resulting combination of references proposed must show or suggest at least the claimed invention. *See, e.g., In re Wright*, 6 U.S.P.Q.2d (BNA) 1959, 1962 (Fed. Cir. 1988), *overruled in part by In re Dillon*, 16 U.S.P.Q.2d (BNA) 1897 (Fed. Cir. 1990), *and cert. denied*, 500 U.S. 904 (1991); *In re Nielson*, 2 U.S.P.Q.2d (BNA) 1525, 1528 (Fed. Cir. 1987).

B. The cited references, alone or in proper combination, do not render claims 26 and 29-31 obvious and unpatentable under 35 U.S.C. § 103(a).

In the Office Action, the Examiner rejected claims 26 and 29-31 under 35 U.S.C. § 103(a) as being unpatentable over Trolle in view of Barma et al. Office Action, p. 3.

1. U.S. Patent No. 1,141,889 to Trolle (issued June 1, 1915).

Trolle discloses an exterior, metal "bottom" (i.e., sole) for shoes and boots. Trolle, p. 2, ll. 10-12. A shoe incorporating the Trolle metal sole "A" purportedly withstands rough usage

and provides protection against a number of undesirable elements. P. 1, ll. 52-55. Clearly, though, a shoe with a metal sole would be uncomfortable for the wearer and difficult in which to walk, particular on slippery surfaces. P. 2, ll. 35-38. Accordingly, Trolle includes a plurality of flexible, ground engaging surfaces "C," "D" under the heel and ball of the foot that apparently increase comfort and stability. P. 2, ll. 35-38, 57-69. As shown in Trolle Figure 2, the metal sole "A" is raised above the ground by the ground engaging surfaces "C," "D."

2. U.S. Patent No. 5,546,680 to Barma et al. (issued Aug. 20, 1996).

Barma et al. discloses a safety footwear product (i.e., rubber boot) 10 that includes protective plates 32, 54 purportedly to prevent sharp objects from puncturing the boot 10 and injuring the wearer. Barma et al., col. 2, ll. 14-23. One protective plate 54 spans the entire width and length of the ground-contacting portion of the outsole 27. Col. 3, ll. 54-57. A second protective plate 32 is located on the side, instep area of the boot 10. Col. 2, ll. 62-53. The plates 32, 54 may be metal or rigid plastic. Col. 3, ll. 4-7; 57-59. The plates 32, 54 are preferably embedded in the boot 10, but they may also be mounted on the exterior. Col. 2, ll. 66-67; col. 4, ll. 56-61.

The Office Action states that it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to use polymeric materials, such as the rigid plastics of Barma et al., in a chassis. Office Action, p. 3.

3. The cited references, alone or in proper combination, do not render claim 26 unpatentable under 35 U.S.C. § 103(a).

Claim 26 is directed to an article of footwear that includes a sole with at least one cleat that is proximate to one or both of the lateral and medial sides of the article of footwear, and a generally planar polymeric chassis that extends substantially along an entire length of the heel and toe portions of the article of footwear. Appellant respectfully submits that at least these aspects of claim 26 clearly and patentably distinguish the claimed invention over Trolle and Barma et al., that claim 26 is nonobvious in view of these references, and that claim 26 is separately patentable from the remaining claims.

As an initial matter, Trolle neither teaches nor suggests Appellant's claimed chassis. The Office Action mischaracterizes Trolle by referring to the metal shoe bottom "A" as a chassis. Office Action, p. 3. The metal shoe bottom "A" is actually an outsole. Trolle, p. 1, ll. 34-41. As discussed above in connection with the Crowley reference, an outsole is distinguishable from Appellant's chassis. Consequently, Trolle alone cannot support a rejection of claim 26 for obviousness under 35 U.S.C. § 103.

Barma et al. teaches away from Trolle because the former relies on protective plates added to a rubber boot to protect a wearer's foot, whereas the latter employs a metal shoe sole to accomplish the same function. A person of ordinary skill, on reading Barma et al. would be discouraged from following its teachings since the teachings are superfluous to the Trolle disclosure. In other words, there is no need to employ the Barma et al. protective plates in a shoe having a metal sole that by itself protects the wearer's foot. Therefore, following the rule of *In re Gurley*, Barma et al. teaches away from Trolle. *In re Rudko*, then, dictates that claim 26 is nonobvious because Barma et al. teaches away from Trolle.

Appellant's chassis is related to providing, for example, flexibility and effective power transfer. Specification, p. 1, ll. 1-2; p. 2, ll. 1-2. In contrast, the Trolle metal sole "A" and the Barma et al. protective plates are concerned with the problem of protecting the wearer's feet from hazardous conditions. Accordingly, following the rule of *Lindemann*, Appellant's invention is nonobvious in view of the cited references. Appellant respectfully disagrees with the Examiner's assessment of the applicability of *Lindemann*. Office Action, p. 7. In particular, the Examiner states that "all of the applied references are directed towards shoe soles and address stiffness and stability problems." *Id.* The issue is not whether the cited references address the same problem. The proper inquiry is whether the cited references address the same problem that Appellant's claimed invention addresses. As discussed above, Trolle and Barma et al. are not concerned with flexibility and effective power transfer, and, therefore, do not render claim 26 obvious per *Lindemann*.

The Examiner also highlights a portion of the *Lindemann* decision to support the position that *Lindemann* is applicable only when a cited reference discloses an "entirely different device, composed of parts distinct from those of the claimed invention, and operating in a different way

to process different material differently.” Office Action, p. 7 (quoting *Lindemann*, 221 U.S.P.Q. (BNA) at 486). This portion of *Lindemann* applies to a rejection of claims anticipated under 35 U.S.C. § 102(b). *Id.* In the instant case, the rejection is for obviousness under 35 U.S.C. § 103. Consequently, the Examiner’s reliance on the highlighted portion of *Lindemann* is inapposite. With respect to rejections under 35 U.S.C. § 103, *Lindemann* stands for the proposition that a claimed invention is nonobvious if the elements in a reference deal with problems different from those addressed by the claimed invention, without the limitation that the Examiner emphasized. *Lindemann*, 221 U.S.P.Q. (BNA) at 488-89.

Although the claimed invention and reference discussed in *Lindemann* each dealt with waste processing apparatus, their operational environments (i.e., the nature of the waste handled by each) presented different problems that the corresponding inventions addressed. *Lindemann*, 221 U.S.P.Q. (BNA) at 487. Accordingly, the court held that the reference did not render claims obvious under 35 U.S.C. § 103. *Lindemann*, 221 U.S.P.Q. (BNA) at 489. Similarly, even though Appellant’s claimed invention, and the Trolle and Barma et al. references, all deal with footwear-related apparatus, Appellant respectfully submits that any attempt to rely on this commonality is an overly broad definition of the problem and is insufficient to establish a basis for an obviousness rejection. *Lindemann*, 221 U.S.P.Q. (BNA) at 487. The elements of Appellant’s claimed invention, Trolle, and Barma et al. deal with the different problems presented by the different operational environments (i.e., Appellant’s claimed invention in a sporting event, and Trolle and Barma et al. in hazardous conditions). Following *Lindemann*, Appellant’s claim 26 is nonobvious.

In view of the above, Appellant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness of claim 26. Appellant respectfully submits that claim 26 clearly and patentably distinguishes the claimed invention over Trolle and Barma et al., that claim 26 is nonobvious in view of these references, and that claim 26 is separately patentable from the remaining claims.

4. The cited references, alone or in proper combination, do not render claim 29 unpatentable under 35 U.S.C. § 103(a).

Claim 29 is directed to the article of footwear of claim 26, wherein the sole is an outsole. P. 4, ll. 9-10. Appellant respectfully submits that at least this aspect of claim 29 clearly and patentably distinguishes the claimed invention over Trolle and Barma et al., that claim 29 is nonobvious in view of these references, and that claim 29 is separately patentable from the remaining claims.

Trolle discloses a metal shoe bottom “A” that is an outsole. Trolle, p. 1, ll. 34-41. An objective of Trolle is to prevent injury to the wearer’s feet due to hazardous conditions. P. 1, ll. 44-55. Trolle metal outsole “A” is sufficiently resilient and resists the effects of these conditions. Barma et al. also discloses an outsole 27, but one made of rubber. Barma et al., col. 1, l. 61. Barma et al. recognizes that the rubber outsole 27 provides inadequate protection for the wearer, because Barma et al. adds protective plates 32, 54 at specific locations on the footwear product. Col. 2, ll. 14-23. Accordingly, with respect to Appellant’s claimed outsole, Barma et al. teaches away from Trolle since a person of ordinary skill, on reading Barma et al., would be discouraged from employing an outsole like that Barma et al. discloses because the latter inadequately protects the wearer’s feet from the hazards Trolle discusses unless protective plates 32, 54, which are separate and distinct from the outsole, are added, likely resulting in increased manufacturing cost and complexity. Following the rule of *In re Rudko*, Appellant’s claim 29 is nonobvious.

Further, and as discussed above in connection with independent claim 26, the combination of Trolle and Barma et al. as set forth in the Office Action fails to render claim 26 obvious. With respect to claim 29, which depends from claim 26 and includes the limitations thereof, Appellant respectfully submits that the additional limitation of the outsole further distinguishes Appellant’s claimed invention over the cited references. The resulting combination of these references as set forth in the Office Action fails to show or suggest at least the limitations of the parent claim and this additional limitation in Appellant’s claimed invention. Accordingly, a prima facie case of obviousness has not been established with respect to claim 29. *See, e.g., In re Wright* and *In re Nielson*.

Appellant respectfully submits that at least the outsole limitation of claim 29 clearly and patentably distinguishes the claimed invention over Trolle and Barma et al., that claim 29 is nonobvious in view of these references, and that claim 29 is separately patentable from the remaining claims.

5. The cited references, alone or in proper combination, do not render claims 30 and 31 unpatentable under 35 U.S.C. § 103(a).

Claim 30 is directed to the article of footwear of claim 26, where a lug extends from the bottom side of the chassis. Figure 3A, RD 230; p. 10, ll. 18-19. Claim 31 is directed to the article of footwear of claim 30, wherein the lug projects into the cleat. Figure 3A, RD 230, 232; p. 10, ll. 19-20. Appellant respectfully submits that at least the lug and projection limitations of claims 30 and 31, respectively, clearly and patentably distinguish the claimed invention over Trolle and Barma et al., that claims 30 and 31 are nonobvious in view of these references, and that claims 30 and 31 are separately patentable from the remaining claims.

Trolle discloses mounting flanges 11, 12 and studs 20, 31 that extend only slightly from the outsole "A" into the ground engaging surfaces "C," "D" to facilitate mounting. As discussed above, Trolle neither teaches nor suggests a chassis. Other than what appears to be a tread pattern shown in Barma et al. Figure 1, near the lead line for RD 27, Barma et al. is silent on projections from the footwear product.

Appellant's claimed lug is a projection that extends from the chassis into a cleat, thereby supporting the latter. P. 4, ll. 12-13. Accordingly, the shape of the lug is comparable to the cleat it supports. P. 4, ll. 13-14. With respect to claim 30, the combination of Trolle and Barma et al. fails to show or suggest at least a chassis from which a lug projects. With respect to claim 31, and to the extent that the combination of these references show any projection from the footwear product, the combination of the references fails to show or suggest a projection that extends into a cleat as Appellant claims. Accordingly, a prima facie case of obviousness has not been established with respect to these elements of Appellant's claimed invention. *See, e.g., In re Wright and In re Nielson.*

Further, and as discussed above in connection with independent claim 26, the combination of Trolle and Barma et al. as set forth in the Office Action fails to render claim 26 obvious. Claim 30 depends directly from claim 26 and includes the limitations thereof. Claim 31 depends directly from claim 30 and indirectly from claim 31, and includes all of the limitations of each. Consequently, Appellant respectfully submits that the additional limitations in claims 30 and 31 regarding the lug and its projection further distinguish Appellant's claimed invention over the cited references. The resulting combination of these references as set forth in the Office Action fails to show or suggest at least the limitations of the parent claims and the additional limitations in Appellant's claimed invention. Accordingly, a prima facie case of obviousness has not been established with respect to claims 30 and 31. *See, e.g., In re Wright* and *In re Nielson*.

Appellant respectfully submits that at least the lug and projection limitations of claims 30 and 31, respectively, clearly and patentably distinguish the claimed invention over Trolle and Barma et al., that claims 30 and 31 are nonobvious in view of these references, and that claims 30 and 31 are separately patentable from the remaining claims.

IV. Claims 1, 4, 6-10, 19, and 26-29 constitute nonobvious subject matter and are patentable over Lorenzi et al. (U.S. Pat. No. 1,684,676).

A. The cited reference does not render claims 1, 4, 6-10, 19, and 26-29 obvious and unpatentable under 35 U.S.C. § 103(a).

In the Office Action, the Examiner rejected claims 1, 4, 6-10, 19, and 26-29 under 35 U.S.C. § 103(a) as being unpatentable over Lorenzi. Office Action, p. 3.

1. U.S. Patent No. 1,684,676 to Lorenzi et al. (issued Feb. 7, 1925).

Lorenzi et al. discloses a metal stiffening plate 4 that is mounted on the upper side of the rubber sole and heel section of a shoe. Lorenzi et al., p. 2, ll. 89-92. The metal stiffening plate 4 includes a tongue 5 that extends from a cross piece 6 into the forefoot region of the shoe. Lorenzi et al., Figure 1; p. 2, ll. 22-26. The metal stiffening plate 4 also extends about the periphery of the shoe to include a plurality of openings 9. Figure 1; p. 1, ll. 98-100.

The Office Action states that it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to use polymeric materials and form a chevron shaped opening in a chassis. Office Action, pp. 3-4.

2. The cited reference does not render claim 1 unpatentable under 35 U.S.C. § 103(a).

Claim 1 is directed to a single piece generally planar polymeric chassis for an article of footwear. The chassis includes a plurality of elongated elements extending into the forefoot portion, and at least one elongated element extending into the heel portion. Appellant respectfully submits that at least these aspects of claim 1 clearly and patentably distinguish the claimed invention over Lorenzi et al., that claim 1 is nonobvious in view of this reference, and that claim 1 is separately patentable from the remaining claims.

As discussed above, Appellant's chassis is related to providing, for example, flexibility and effective power transfer. Specification, p. 1, ll. 1-2; p. 2, ll. 1-2. In contrast, Lorenzi et al. is concerned with "prevent[ing] the upturning or curling of the toe portions of the sole of the boot." Lorenzi et al., p. 2, ll. 65-70. Accordingly, following the rule of *Lindemann*, Appellant's claim 1 is not rendered obvious in view of this reference. Appellant respectfully submits that, even though both Lorenzi et al. and Appellant's claimed invention relate to footwear-related apparatus, relying on this commonality results in an overly broad definition of the problem solved by Appellant's invention, and is therefore insufficient to establish a basis for an obviousness rejection. *Lindemann*, 221 U.S.P.Q. (BNA) at 487.

Lorenzi et al. also does not teach or suggest Appellant's claimed plurality of elongated elements in the forefoot portion and at least one elongated element in the rearfoot portion. Rather, Lorenzi et al. discloses a metal stiffening plate 4 that includes a single element (the tongue 5) and a continuous, circumferential portion that follows the periphery of the shoe. Given its location, this circumferential portion is responsible for preventing the curling of toe portion of the boot. At p. 2, ll. 22-24, Lorenzi et al. describes the tongue 5 as providing "resiliency in the sole," a characterization that Lorenzi et al. does not similarly ascribe to the circumferential portion. Thus, based on its disclosed configuration and function, the circumferential portion is

clearly distinguishable from the independent elongated elements Appellant claims and depicts in, for example, Figures 1A, 2A, 3A, and 4. Accordingly, the circumferential portion, in combination with the tongue 5, cannot be relied on to teach or suggest Appellant's claimed plurality of elongated elements in the forefoot portion and at least one elongated element in the rearfoot portion. Lorenzi et al. offers no teaching or suggestion to add other elements. A person of ordinary skill, then, on reading Lorenzi et al., would be discouraged from following the path set out therein, or would be led in a direction divergent from the path that Appellant took, meaning Lorenzi et al. teaches away from Appellant's claimed invention. *See, e.g., In re Gurley*, 31 U.S.P.Q.2d (BNA) at 1131. Consequently, there is no motivation to modify Lorenzi et al. to arrive at Appellant's claimed invention, meaning claim 1 is nonobvious in view of Lorenzi et al.

Further, the modification of Lorenzi et al. detailed in the Office Action, i.e., the use of polymeric materials (Office Action, p. 3), fails to address Appellant's claimed generally planar chassis and plurality of elongated elements. Accordingly, a prima facie case of obviousness has not been established with respect to claim 1. *See, e.g., In re Wright and In re Nielson*.

In view of the above, Appellant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness of claim 1. Appellant respectfully submits that claim 1 clearly and patentably distinguishes the claimed invention over Lorenzi et al., that claim 1 is nonobvious in view of this reference, and that claim 1 is separately patentable from the remaining claims.

3. The cited reference does not render claims 4 and 7 unpatentable under 35 U.S.C. § 103(a).

Claim 4 is directed to the chassis of claim 1 wherein the forefoot portion comprises three elongated elements. Figure 1A, RD 10; p. 6, ll. 9-10; Figure 2A, RD 110; p.8, ll. 11-12; Figure 3A, RD 210; p. 10, ll. 23-24; Figure 4, RD 310; p. 13, ll. 9-10. Claim 7 is directed to the chassis of claim 4 wherein the forefoot portion elongated elements are disposed adjacent one another. P. 6, ll. 10-11; p. 13, ll. 12-13. Appellant respectfully submits that at least the three elongated element and adjacent arrangement limitations of claims 4 and 7, respectively, clearly and patentably distinguish the claimed invention over Lorenzi et al., that claims 4 and 7 are

nonobvious in view of this reference, and that claims 4 and 7 are separately patentable from the remaining claims.

As discussed above, Lorenzi et al. shows, at most, only one element: tongue 5, and offers no teaching or suggestion to add other elements. Necessarily, then, Lorenzi et al. fails to teach or suggest the three elongated elements of claim 4. With respect to claim 7, then, Lorenzi et al. cannot teach or suggest an adjacent relationship between the three elongated elements if it initially fails to teach or suggest three elongated elements.

Further, and as discussed above in connection with independent claim 1, the modification of Lorenzi et al. as set forth in the Office Action (i.e., the use of polymeric materials) fails to render claim 1 obvious. Claim 4 depends directly from claim 1 and includes the limitations thereof. Claim 7 depends directly from claim 4 and indirectly from claim 1, and includes all of the limitations of each. Consequently, Appellant respectfully submits that the additional limitations of claims 4 and 7 regarding the three elongated elements and their adjacent arrangement further distinguish Appellant's claimed invention over the reference. The resulting modification of Lorenzi et al. as set forth in the Office Action fails to show or suggest at least the claimed limitations of the parent claims (e.g., the generally planar chassis) and these additional limitations of Appellant's claimed invention. Accordingly, a prima facie case of obviousness has not been established with respect to claims 4 and 7. *See, e.g., In re Wright and In re Nielson.*

Appellant respectfully submits that at least the three, adjacent elongated elements of claims 4 and 7 clearly and patentably distinguish the claimed invention over Lorenzi et al., that claims 4 and 7 are nonobvious in view of this reference, and that claims 4 and 7 are separately patentable from the remaining claims.

4. The cited reference does not render claims 6 and 8 unpatentable under 35 U.S.C. § 103(a).

Claim 6 is directed to the chassis of claim 1 wherein the rearfoot portion has two elongated elements. P. 3, ll. 4-5. Claim 8 is directed to the chassis of claim 6 wherein the rearfoot portion elongated elements are disposed adjacent one another. P. 13, ll. 12-13. Appellant respectfully submits that at least the two elongated element and adjacent arrangement

limitations of claims 6 and 8, respectively, clearly and patentably distinguish the claimed invention over Lorenzi et al., that claims 6 and 8 are nonobvious in view of this reference, and that claims 6 and 8 are separately patentable from the remaining claims.

Lorenzi et al. shows, at most, only one element, the tongue 5, which does not extend from the midfoot portion into the heel portion. Lorenzi et al., Figure 1. Lorenzi et al. neither teaches nor suggests the presence of any elongated elements located in the rearfoot portion of the chassis as claimed in Appellant's claim 6. With respect to claim 8, then, Lorenzi et al. cannot teach or suggest an adjacent relationship between the rearfoot elongated elements if it initially fails to teach or suggest any rearfoot elongated elements.

Further, and as discussed above in connection with independent claim 1, the modification of Lorenzi et al. as set forth in the Office Action (i.e., the use of polymeric materials) fails to render claim 1 obvious. Claim 6 depends directly from claim 1 and includes the limitations thereof. Claim 8 depends directly from claim 6 and indirectly from claim 1, and includes all of the limitations of each. Consequently, Appellant respectfully submits that the additional limitations of claims 6 and 8 regarding the two elongated elements and their adjacent arrangement further distinguish Appellant's claimed invention over the reference. The resulting modification of Lorenzi et al. as set forth in the Office Action fails to show or suggest at least the claimed limitations of the parent claims (e.g., the generally planar chassis) and these additional limitations of Appellant's claimed invention. Accordingly, a prima facie case of obviousness has not been established with respect to claims 6 and 8. *See, e.g., In re Wright and In re Nielson.*

Appellant respectfully submits that at least the two, adjacent rearfoot elongated elements of claims 6 and 8 clearly and patentably distinguish the claimed invention over Lorenzi et al., that claims 6 and 8 are nonobvious in view of this reference, and that claims 6 and 8 are separately patentable from the remaining claims.

5. The cited reference does not render claims 9 and 10 unpatentable under 35 U.S.C. § 103(a).

Claim 9 is directed to the chassis of claim 1 wherein the rearfoot portion comprises two elements that define an opening between them. P. 3, ll. 4-5. Claim 10 is directed to the chassis

of claim 9 wherein the opening is in a form of a chevron. P. 6, ll. 15-16. Appellant respectfully submits that at least the two element and chevron shape limitations of claims 9 and 10, respectively, clearly and patentably distinguish the claimed invention over Lorenzi et al., that claims 9 and 10 are nonobvious in view of this reference, and that claims 9 and 10 are separately patentable from the remaining claims.

Lorenzi et al. discloses a metal stiffening plate 4 that mounted about the circumference of the shoe. Lorenzi et al., Figure 1. The metal stiffening plate 4 is continuous and, about the heel area, defines an opening 8. P. 1, ll. 95-97. In the heel area, the continuous nature of the metal stiffening plate 4 results in a single-piece configuration. Figure 1. Accordingly, Lorenzi et al. neither teaches nor suggests the two rearfoot elements defining an opening therebetween as claimed in Appellant's claim 9. With respect to claim 10, then, Lorenzi et al. cannot teach or suggest an opening in the form of a chevron if it initially fails to teach or suggest the two rearfoot elements that define the opening.

Further, and as discussed above in connection with independent claim 1, the modification of Lorenzi et al. as set forth in the Office Action (i.e., the use of polymeric materials) fails to render claim 1 obvious. Claim 9 depends directly from claim 1 and includes the limitations thereof. Claim 10 depends directly from claim 9 and indirectly from claim 1, and includes all of the limitations of each. Consequently, Appellant respectfully submits that the additional limitations of claims 9 and 10 regarding the two rearfoot elements and the chevron shaped opening defined thereby further distinguish Appellant's claimed invention over the reference. The resulting modification of Lorenzi et al. as set forth in the Office Action fails to show or suggest at least the claimed limitations of the parent claims (e.g., the generally planar chassis) and these additional limitations of Appellant's claimed invention. Further, Appellant's opening in the form of a chevron is not a merely a design choice as the Office Action asserts. Office Action, p. 4. The claimed opening has the specific shape and position necessary to provide cushioning in the heel region 109 and to permit cleat formation. P. 10, ll. 1-4. In view of the above, a prima facie case of obviousness has not been established with respect to claims 9 and 10. See, e.g., *In re Wright* and *In re Nielson*.

Appellant respectfully submits that at least the two rearfoot elements defining a chevron shaped opening therebetween of claims 9 and 10 clearly and patentably distinguish the claimed invention over Lorenzi et al., that claims 9 and 10 are nonobvious in view of this reference, and that claims 9 and 10 are separately patentable from the remaining claims.

6. The cited reference does not render claim 19 unpatentable under 35 U.S.C. § 103(a).

Claim 19 is directed to the chassis of claim 1, wherein the chassis includes a common midfoot portion. P. 6, ll. 5-6. Appellant respectfully submits that at least this aspect of claim 19 clearly and patentably distinguishes the claimed invention over Lorenzi et al., that claim 19 is nonobvious in view of this reference, and that claim 19 is separately patentable from the remaining claims.

Appellant's claimed common midfoot portion 4 is characterized by uninterrupted chassis material in the midfoot area that connects the entire forefoot portion 6 with the entire rearfoot portion 8. Figure 1A. The midfoot portion is "common" to the forefoot and rearfoot portions 6, 8 at least because it forms an uninterrupted connection between the two. In contrast, Lorenzi et al. discloses a cross piece 6 disposed at the base of the forefoot portion of the metal stiffening plate 4. Lorenzi et al., p. 1, l. 95; Figure 1. Rearward and parallel to the cross piece 6 is another segment (undesigned) of the metal stiffening plate 4 that is disposed at the beginning of the rearfoot portion. Figure 1. This segment and the cross piece 6, in conjunction with the lateral and medial circumferential portions of the metal stiffening plate 4, define an opening 7. Lorenzi et al., p. 1, ll. 95-97; Figure 1.

Claim 19 is nonobvious in view of Lorenzi et al. because there is no motivation to modify the reference to arrive at Appellant's claimed invention. There is no motivation to modify the reference because Lorenzi et al. teaches away from Appellant's claimed invention. Specifically, the midfoot portion of Lorenzi et al. is characterized by the absence of material, i.e., the midfoot portion is the opening 7. A person of ordinary skill, on reading Lorenzi et al., would be discouraged from employing a structure having uninterrupted material between the forefoot and

rearfoot to create the claimed common midfoot portion. Accordingly, Lorenzi et al. teaches away from Appellant's claimed invention. *See, e.g., In re Gurley*, 31 U.S.P.Q.2d (BNA) at 1131.

Further, and as discussed above in connection with independent claim 1, the modification of Lorenzi et al. as set forth in the Office Action (i.e., the use of polymeric materials) fails to render claim 1 obvious. Claim 19 depends directly from claim 1 and includes the limitations thereof. Consequently, Appellant respectfully submits that the additional limitation of claim 19 regarding the common midfoot portion further distinguishes Appellant's claimed invention over the reference. The resulting modification of Lorenzi et al. as set forth in the Office Action fails to show or suggest at least the claimed limitations of the parent claim (e.g., the generally planar chassis) and these additional limitations of Appellant's claimed invention. Accordingly, a prima facie case of obviousness has not been established with respect to claim 19. *See, e.g., In re Wright and In re Nielson*.

Appellant respectfully submits that at least the common midfoot of claim 19 clearly and patentably distinguishes the claimed invention over Lorenzi et al., that claim 19 is nonobvious in view of this reference, and that claim 19 is separately patentable from the remaining claims.

7. The cited reference does not render claim 26 unpatentable under 35 U.S.C. § 103(a).

Claim 26 is directed to an article of footwear that includes a sole with at least one cleat that is proximate to one or both of the lateral and medial sides of the article of footwear, and a generally planar polymeric chassis that extends substantially along an entire length of the heel and toe portions of the article of footwear. Appellant respectfully submits that at least these aspects of claim 26 clearly and patentably distinguish the claimed invention over Lorenzi et al., that claim 26 is nonobvious in view of this reference, and that claim 26 is separately patentable from the remaining claims.

As discussed above, Appellant's chassis is related to providing, for example, flexibility and effective power transfer. Specification, p. 1, ll. 1-2; p. 2, ll. 1-2. In contrast, Lorenzi et al. is concerned with "prevent[ing] the upturning or curling of the toe portions of the sole of the boot."

Lorenzi et al., p. 2, ll. 65-70. Accordingly, following the rule of *Lindemann*, Appellant's claim 26 is not rendered obvious in view of this reference.

Further, Appellant's claimed chassis is generally planar, which is distinguishable from the clearly non-planar, stepped nature of the metal stiffening plate 4 depicted in Lorenzi et al. Figure 2. The modification of Lorenzi et al. detailed in the Office Action, i.e., the use of polymeric materials (Office Action, p. 3), fails to address Appellant's claimed generally planar chassis. Accordingly, Appellant respectfully submits that this modification is an inadequate basis for an obviousness rejection at least in view of Appellant's claimed generally planar element.

In view of the above, Appellant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness of claim 26. Appellant respectfully submits that claim 26 clearly and patentably distinguishes the claimed invention over Lorenzi et al., that claim 26 is nonobvious in view of this reference, and that claim 26 is separately patentable from the remaining claims.

8. The cited reference does not render claims 27 and 28 unpatentable under 35 U.S.C. § 103(a).

Claim 27 is directed to the article of footwear of claim 26, wherein the chassis includes an elongated element extending toward a toe portion from a midfoot portion, and an elongated element extending toward a heel portion from the midfoot portion. Figure 3A. Claim 28 is directed to the article of footwear of claim 26, wherein the chassis includes a plurality of elongated elements extending generally from a heel portion to a toe portion. *Id.* Appellant respectfully submits that at least the elongated element limitations of claims 27 and 28 clearly and patentably distinguish the claimed invention over Lorenzi et al., that claims 27 and 28 are nonobvious in view of this reference, and that claims 27 and 28 are separately patentable from the remaining claims.

As discussed above, Lorenzi et al. neither teaches nor suggests any of Appellant's claimed elongated elements. Rather, the Lorenzi et al. metal stiffening plate 4 includes a single element (the tongue 5) and a continuous, circumferential portion that follows the periphery of the shoe. Based on its disclosed configuration and function, the circumferential portion is clearly

distinguishable from the elongated elements Appellant claims and depicts in, for example, Figures 1A, 2A, 3A, and 4. Accordingly, the circumferential portion, in combination with the tongue 5, cannot be relied on to teach or suggest Appellant's claimed elongated element in the forefoot and rearfoot portions (claim 27) or a plurality of elongated elements extending generally from the heel to toe portion (claim 28). Lorenzi et al. further offers no teaching or suggestion to add other elements. A person of ordinary skill, then, on reading Lorenzi et al., would be discouraged from following the path set out therein, or would be led in a direction divergent from the path that Appellant took, meaning Lorenzi et al. teaches away from Appellant's claimed invention. *See, e.g., In re Gurley*, 31 U.S.P.Q.2d (BNA) at 1131. Consequently, there is no motivation to modify Lorenzi et al. to arrive at Appellant's claimed invention, meaning claims 27 and 28 are nonobvious in view of Lorenzi et al.

Further, and as discussed above, the modification of Lorenzi et al. as set forth in the Office Action (i.e., the use of polymeric materials) fails to render claim 26 obvious. Claims 27 and 28 depend directly from claim 26 and include the limitations thereof. Consequently, Appellant respectfully submits that the additional limitations of claims 27 and 28 regarding the elongated elements further distinguish Appellant's claimed invention over the reference. The resulting modification of Lorenzi et al. as set forth in the Office Action fails to show or suggest at least the claimed limitations of the parent claims (e.g., the generally planar chassis) and these additional limitations of Appellant's claimed invention. Accordingly, a prima facie case of obviousness has not been established with respect to claims 27 and 28. *See, e.g., In re Wright* and *In re Nielson*.

Appellant respectfully submits that at least the elongated elements of claims 27 and 28 clearly and patentably distinguish the claimed invention over Lorenzi et al., that claims 27 and 28 are nonobvious in view of this reference, and that claims 27 and 28 are separately patentable from the remaining claims.

9. The cited reference does not render claim 29 unpatentable under 35 U.S.C. § 103(a).

Claim 29 is directed to the article of footwear of claim 26, wherein the sole is an outsole. P. 4, ll. 9-10. Appellant respectfully submits that at least this aspect of claim 29 clearly and patentably distinguishes the claimed invention over Lorenzi et al., that claim 29 is nonobvious in view of this reference, and that claim 29 is separately patentable from the remaining claims.

As discussed above, the modification of Lorenzi et al. as set forth in the Office Action (i.e., the use of polymeric materials) fails to render claim 26 obvious. Claim 29 depends directly from claim 26 and includes the limitations thereof. Consequently, Appellant respectfully submits that the additional limitations of claim 29 regarding the outsole further distinguishes Appellant's claimed invention over the reference. The resulting modification of Lorenzi et al. as set forth in the Office Action fails to show or suggest at least the claimed limitations of the parent claims (e.g., the generally planar chassis) and these additional limitations of Appellant's claimed invention. Accordingly, a prima facie case of obviousness has not been established with respect to claim 29. *See, e.g., In re Wright and In re Nielson.*

Further, as discussed above, Appellant's chassis is related to providing, for example, flexibility and effective power transfer. Specification, p. 1, ll. 1-2; p. 2, ll. 1-2. In contrast, Lorenzi et al. is concerned with "prevent[ing] the upturning or curling of the toe portions of the sole of the boot." Lorenzi et al., p. 2, ll. 65-70. Accordingly, following the rule of *Lindemann*, Appellant's claim 29, which includes the limitation of a generally planar chassis by virtue of its dependency from claim 26, is not rendered obvious in view of this reference.

Appellant respectfully submits that at least the outsole limitation of claim 29 clearly and patentably distinguishes the claimed invention over Lorenzi et al., that claim 29 is nonobvious in view of this reference, and that claim 29 is separately patentable from the remaining claims.

V. **Claims 1, 5, 6, 8-10, 12-23, and 39 constitute nonobvious subject matter and are patentable over Giese et al. (U.S. Pat. No. 5,572,805) in view of Tong et al. (U.S. Pat. No. 5,185,943) or Brown (U.S. Pat. No. D446,917) and Thomas (U.S. Pat. No. 444,735).**

A. **The cited references, alone or in proper combination, do not render claims 1, 5, 6, 8-10, 12-23, and 39 obvious and unpatentable under 35 U.S.C. § 103(a).**

In the Office Action, the Examiner rejected claims 1, 5, 6, 8-10, 12-23, and 39 under 35 U.S.C. § 103(a) as being unpatentable over Giese et al. in view of Tong et al. or Brown and Thomas. Office Action, p. 4.

1. U.S. Patent No. 5,572,805 to Giese et al. (issued Nov. 12, 1996).

Giese et al. discloses a composite shoe bottom with a lower layer 2, an upper layer 3, and stabilizer 19 molded therebetween above the lower layer 2. Giese et al., col. 11, l. 67 – col. 12, l. 2; Figures 111 – 116. The stabilizer 19 includes stabilizer arms 29 that are confined to the area about the ball of the foot and that do not extend into the forefoot area. Col. 12, ll. 7-10; Figure 111.

2. U.S. Patent No. D446,917 to Brown (issued Aug. 28, 2001).

Brown is a design patent that discloses a sole insert for a shoe. The Brown insert is depicted in isolation without, for example, the benefit of one or more phantom lines that would show its location in a shoe. Consequently, the size, location, and extent of the Brown insert relative to a shoe in which it is installed are unknown.

3. U.S. Patent No. 444,735 to Thomas (issued Jan. 13, 1891).

Thomas discloses an insole with separate metallic plates Z and C. Thomas requires separate plates to achieve the desired voltaic effect (i.e., between Z and C). Accordingly, Thomas teaches away from any requirement that an insole structure have single piece construction.

The Office Action states that it would have been obvious to, in a chassis, extend forefoot elements, form a chevron shaped opening, and use different materials in different regions. Office Action, pp. 3-4. It is unclear whether, in the instant ground of rejection, the Examiner has applied the proper standard of obviousness, because the Office Action does not refer to what would have been obvious to one of ordinary skill in the art at the time the invention was made.

4. The cited references, alone or in proper combination, do not render claim 1 unpatentable under 35 U.S.C. § 103(a).

Claim 1 is directed to a single piece generally planar polymeric chassis for an article of footwear. The chassis includes a plurality of elongated elements extending into substantially the entire length of the forefoot portion, and at least one elongated element extending into substantially the entire length of the heel portion. Appellant respectfully submits that at least these aspects of claim 1 clearly and patentably distinguish the claimed invention over Giese et al., Tong et al., Brown, and Thomas, that claim 1 is nonobvious in view of these references, and that claim 1 is separately patentable from the remaining claims.

Based on the discussion in the Office Action, it appears that the Examiner has advanced the instant rejection using two alternative combinations of the references: (i) Giese et al. in view of Tong et al., and (ii) Giese et al. in view of Brown and Thomas. Office Action, p. 4. With respect to the first alternative, Appellant respectfully submits that the proposed combination of references fails to show or suggest the claimed limitations of Appellant's claimed invention. For example, the combination of Giese et al. and Tong et al. results in a structure having an undulating or sinusoidal shape in cross section, in contrast to Appellant's claimed generally planar chassis. Accordingly, a prima facie case of obviousness has not been established with respect to claim 1. *See, e.g., In re Wright and In re Nielson.*

Regarding the second alternative combination of the references, the Brown design patent fails to teach or suggest the extent of the insert relative to the shoe in which the insert is installed. As depicted in Brown Figures 1-5, the extent of the purported forefoot area of the Brown insert is undefined. Consequently, Brown cannot be said to teach or suggest any particular extent of the forefoot elongated elements. Thomas teaches the use of separate metallic plates to create a

voltaic effect. Thomas, then, teaches away from both Giese et al. and Brown, since these two references use single component structures (i.e., the Giese et al. stabilizer 19 and the Brown insert). Following the rule of *In re Rudko*, then, Appellant's claim 1 is nonobvious.

In view of the above, Appellant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness of claim 1. Appellant respectfully submits that claim 1 clearly and patentably distinguishes the claimed invention over Giese et al., Tong et al., Brown, and Thomas, that claim 1 is nonobvious in view of these references, and that claim 1 is separately patentable from the remaining claims.

5. The cited references, alone or in proper combination, do not render claim 5 unpatentable under 35 U.S.C. § 103(a).

Claim 5 is directed to the chassis of claim 1 wherein an elongated element has at least one indentation (i.e., "fold line") along a width of the chassis. Figure 2A, RD 122; p. 8, ll. 11-12; Figure 3A, RD 222; p. 10, ll. 23-24; Amendment and Response, Aug. 29, 2001, p. 10. Appellant respectfully submits that at least these aspects of claim 5 clearly and patentably distinguish the claimed invention over Giese et al., Tong et al., Brown, and Thomas, that claim 5 is nonobvious in view of these references, and that claim 5 is separately patentable from the remaining claims.

With respect to the proposed combination of Giese et al. and Tong et al., neither reference teaches or suggests the presence of Appellant's claimed indentation. Appellant's claimed indentation, depicted in, for example, Figures 2A and 3A, increases the flexibility of the chassis. P. 8, ll. 12-17; p. 10, ll. 23-24. As shown in, for example, Giese et al. Figure 111 and Tong et al. Figure 16, these references lack any teaching or suggestion to employ such a structure. Consequently, the proposed combination of these references fails to show or suggest the limitation of claim 5, meaning a prima facie case of obviousness has not been established with respect to claim 5. *See, e.g., In re Wright and In re Nielson.*

Regarding the proposed combination of Giese et al., Brown, and Thomas, Appellant respectfully submits that, as discussed above, Thomas teaches away from both Giese et al. and Brown, meaning, per the rule of *In re Rudko*, Appellant's claim 5 is nonobvious.

Appellant respectfully submits that at least the indentation element of claim 5 clearly and patentably distinguishes the claimed invention over Giese et al., Tong et al., Brown, and Thomas, that claim 5 is nonobvious in view of these references, and that claim 5 is separately patentable from the remaining claims.

6. The cited references, alone or in proper combination, do not render claims 6 and 8 unpatentable under 35 U.S.C. § 103(a).

Claim 6 is directed to the chassis of claim 1 wherein the rearfoot portion has two elongated elements. P. 3, ll. 4-5. Claim 8 is directed to the chassis of claim 6 wherein the rearfoot portion elongated elements are disposed adjacent one another. P. 13, ll. 12-13. Appellant respectfully submits that at least the two elongated element and adjacent arrangement limitations of claims 6 and 8, respectively, clearly and patentably distinguish the claimed invention over Giese et al., Tong et al., Brown, and Thomas, that claims 6 and 8 are nonobvious in view of these references, and that claims 6 and 8 are separately patentable from the remaining claims.

As discussed above in connection with independent claim 1, the proposed combination of Giese et al. and Tong et al. fails to render claim 1 obvious. Claim 6 depends directly from claim 1 and includes the limitations thereof. Claim 8 depends directly from claim 6 and indirectly from claim 1, and includes all of the limitations of each. Consequently, Appellant respectfully submits that the additional limitations of claims 6 and 8 regarding the two elongated elements and their adjacent arrangement further distinguish Appellant's claimed invention over the references. The resulting combination of Giese et al., Tong et al., Brown, and Thomas as set forth in the Office Action fails to show or suggest at least the claimed limitations of the parent claims (e.g., the generally planar chassis) and these additional limitations of Appellant's claimed invention. Accordingly, a prima facie case of obviousness has not been established with respect to claims 6 and 8. *See, e.g., In re Wright and In re Nielson.*

Regarding the proposed combination of Giese et al., Brown, and Thomas, Appellant respectfully submits that, as discussed above, Thomas teaches away from both Giese et al. and Brown, meaning, per the rule of *In re Rudko*, Appellant's claims 6 and 8 are nonobvious.

Appellant respectfully submits that claims 6 and 8 clearly and patentably distinguish the claimed invention over Giese et al., Tong et al., Brown, and Thomas, that claims 6 and 8 are nonobvious in view of these references, and that claims 6 and 8 are separately patentable from the remaining claims.

7. The cited references, alone or in proper combination, do not render claims 9 and 10 unpatentable under 35 U.S.C. § 103(a).

Claim 9 is directed to the chassis of claim 1 wherein the rearfoot portion comprises two elements that define an opening between them. P. 3, ll. 4-5. Claim 10 is directed to the chassis of claim 9 wherein the opening is in a form of a chevron. P. 6, ll. 15-16. Appellant respectfully submits that at least the two element and chevron shape limitations of claims 9 and 10, respectively, clearly and patentably distinguish the claimed invention over Giese et al., Tong et al., Brown, and Thomas, that claims 9 and 10 are nonobvious in view of these references, and that claims 9 and 10 are separately patentable from the remaining claims.

As discussed above in connection with independent claim 1, the proposed combination of Giese et al. and Tong et al. fails to render claim 1 obvious. Claim 9 depends directly from claim 1 and includes the limitations thereof. Claim 10 depends directly from claim 9 and indirectly from claim 1, and includes all of the limitations of each. Consequently, Appellant respectfully submits that the additional limitations of claims 9 and 10 regarding the two rearfoot elements and the chevron shaped opening defined thereby further distinguish Appellant's claimed invention over the references. The resulting combination of Giese et al., Tong et al., Brown, and Thomas as set forth in the Office Action fails to show or suggest at least the claimed limitations of the parent claims (e.g., the generally planar chassis) and these additional limitations of Appellant's claimed invention. Accordingly, a prima facie case of obviousness has not been established with respect to claims 9 and 10. *See, e.g., In re Wright and In re Nielson.*

Regarding the proposed combination of Giese et al., Brown, and Thomas, Appellant respectfully submits that, as discussed above, Thomas teaches away from both Giese et al. and Brown, meaning, per the rule of *In re Rudko*, Appellant's claims 9 and 10 are nonobvious.

Appellant respectfully submits that claims 9 and 10 clearly and patentably distinguish the claimed invention over Giese et al., Tong et al., Brown, and Thomas, that claims 9 and 10 are nonobvious in view of these references, and that claims 9 and 10 are separately patentable from the remaining claims.

8. The cited references, alone or in proper combination, do not render claims 12 and 16 unpatentable under 35 U.S.C. § 103(a).

Claim 12 is directed to the chassis of claim 1 wherein a thickness of a first portion of the chassis is different than a thickness of a second portion of the chassis. P. 4, ll. 15-17. Claim 16 is directed to the chassis of claim 12, wherein the chassis comprises more than two portions, each comprising a different thickness. P. 4, ll. 20-22. Appellant respectfully submits that at least the multiple thickness limitations of claims 12 and 16 clearly and patentably distinguish the claimed invention over Giese et al., Tong et al., Brown, and Thomas, that claims 12 and 16 are nonobvious in view of these references, and that claims 12 and 16 are separately patentable from the remaining claims.

As discussed above in connection with independent claim 1, the proposed combination of Giese et al. and Tong et al. fails to render claim 1 obvious. Claim 12 depends directly from claim 1 and includes the limitations thereof. Claim 16 depends directly from claim 12 and indirectly from claim 1, and includes all of the limitations of each. Consequently, Appellant respectfully submits that the additional limitations of claims 12 and 16 regarding the differing thicknesses further distinguish Appellant's claimed invention over the references. The resulting combination of Giese et al., Tong et al., Brown, and Thomas as set forth in the Office Action fails to show or suggest at least the claimed limitations of the parent claims (e.g., the generally planar chassis) and these additional limitations of Appellant's claimed invention. Accordingly, a prima facie case of obviousness has not been established with respect to claims 12 and 16. *See, e.g., In re Wright and In re Nielson.*

Regarding the proposed combination of Giese et al., Brown, and Thomas, Appellant respectfully submits that, as discussed above, Thomas teaches away from both Giese et al. and Brown, meaning, per the rule of *In re Rudko*, Appellant's claims 12 and 16 are nonobvious.

Appellant respectfully submits that claims 12 and 16 clearly and patentably distinguish the claimed invention over Giese et al., Tong et al., Brown, and Thomas, that claims 12 and 16 are nonobvious in view of these references, and that claims 12 and 16 are separately patentable from the remaining claims.

9. The cited references, alone or in proper combination, do not render claims 13 and 15 unpatentable under 35 U.S.C. § 103(a).

Claim 13 is directed to the chassis of claim 12, wherein the first portion of the chassis comprises the forefoot portion and the second portion comprises the rearfoot portion. P. 4, ll. 17-18. Claim 15 is directed to the chassis of claim 12, wherein the first portion of the chassis comprises the midfoot portion and the second portion comprises the forefoot portion. P. 4, ll. 17-19. Appellant respectfully submits that at least the multiple thickness limitations of claims 13 and 15 clearly and patentably distinguish the claimed invention over Giese et al., Tong et al., Brown, and Thomas, that claims 13 and 15 are nonobvious in view of these references, and that claims 13 and 15 are separately patentable from the remaining claims.

As discussed above in connection with independent claim 1, the proposed combination of Giese et al. and Tong et al. fails to render claim 1 obvious. Claims 13 and 15 depend directly from claim 12 and indirectly from claim 1 and include all of the limitations of each. Consequently, Appellant respectfully submits that the additional limitations of claims 13 and 15 regarding the identity of the different portions further distinguish Appellant's claimed invention over the references. The resulting combination of Giese et al., Tong et al., Brown, and Thomas as set forth in the Office Action fails to show or suggest at least the claimed limitations of the parent claims (e.g., the generally planar chassis) and these additional limitations of Appellant's claimed invention. Accordingly, a prima facie case of obviousness has not been established with respect to claims 13 and 15. *See, e.g., In re Wright and In re Nielson.*

Regarding the proposed combination of Giese et al., Brown, and Thomas, Appellant respectfully submits that, as discussed above, Thomas teaches away from both Giese et al. and Brown, meaning, per the rule of *In re Rudko*, Appellant's claims 13 and 15 are nonobvious.

Appellant respectfully submits that claims 13 and 15 clearly and patentably distinguish the claimed invention over Giese et al., Tong et al., Brown, and Thomas, that claims 13 and 15 are nonobvious in view of these references, and that claims 13 and 15 are separately patentable from the remaining claims.

10. The cited references, alone or in proper combination, do not render claim 14 unpatentable under 35 U.S.C. § 103(a).

Claim 14 is directed to the chassis of claim 12, wherein the first portion of the chassis comprises a first elongated element and the second portion comprises a second elongated element. P. 4, ll. 19-20. Appellant respectfully submits that at least this limitation of claim 14 clearly and patentably distinguishes the claimed invention over Giese et al., Tong et al., Brown, and Thomas, that claim 14 is nonobvious in view of these references, and that claim 14 is separately patentable from the remaining claims.

As discussed above in connection with independent claim 1, the proposed combination of Giese et al. and Tong et al. fails to render claim 1 obvious. Claim 14 depends directly from claim 12 and indirectly from claim 1 and includes all of the limitations of each. Consequently, Appellant respectfully submits that the additional limitations of claim 14 regarding the inclusion of an elongated element in the different portions further distinguishes Appellant's claimed invention over the references. The resulting combination of Giese et al., Tong et al., Brown, and Thomas as set forth in the Office Action fails to show or suggest at least the claimed limitations of the parent claims (e.g., the generally planar chassis) and this additional limitation of Appellant's claimed invention. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 14. *See, e.g., In re Wright* and *In re Nielson*.

Regarding the proposed combination of Giese et al., Brown, and Thomas, Appellant respectfully submits that, as discussed above, Thomas teaches away from both Giese et al. and Brown, meaning, per the rule of *In re Rudko*, Appellant's claim 14 is nonobvious.

Appellant respectfully submits that at least the arrangement of elongated elements of claim 14 clearly and patentably distinguishes the claimed invention over Giese et al., Tong et al.,

Brown, and Thomas, that claim 14 is nonobvious in view of these references, and that claim 14 is separately patentable from the remaining claims.

11. The cited references, alone or in proper combination, do not render claims 17 and 18 unpatentable under 35 U.S.C. § 103(a).

Claim 17 is directed to the chassis of claim 1, wherein a first portion of the chassis comprises a material with properties different than a material of a second portion of the chassis. P. 4, ll. 24-26. Claim 18 is directed to the chassis of claim 17, wherein the chassis comprises more than two portions, each comprising different material properties. P. 4, ll. 26-28. Appellant respectfully submits that at least the multiple material property limitations of claims 17 and 18 clearly and patentably distinguish the claimed invention over Giese et al., Tong et al., Brown, and Thomas, that claims 17 and 18 are nonobvious in view of these references, and that claims 17 and 18 are separately patentable from the remaining claims.

As discussed above in connection with independent claim 1, the proposed combination of Giese et al. and Tong et al. fails to render claim 1 obvious. Claim 17 depends directly from claim 1 and includes the limitations thereof. Claim 18 depends directly from claim 17 and indirectly from claim 1, and includes all of the limitations of each. Consequently, Appellant respectfully submits that the additional limitations of claims 17 and 18 regarding the differing material properties further distinguish Appellant's claimed invention over the references. The resulting combination of Giese et al., Tong et al., Brown, and Thomas as set forth in the Office Action fails to show or suggest at least the claimed limitations of the parent claims (e.g., the generally planar chassis) and these additional limitations of Appellant's claimed invention. Accordingly, a prima facie case of obviousness has not been established with respect to claims 17 and 18. *See, e.g., In re Wright and In re Nielson.*

Regarding the proposed combination of Giese et al., Brown, and Thomas, Appellant respectfully submits that, as discussed above, Thomas teaches away from both Giese et al. and Brown, meaning, per the rule of *In re Rudko*, Appellant's claims 17 and 18 are nonobvious.

Appellant respectfully submits that claims 17 and 18 clearly and patentably distinguish the claimed invention over Giese et al., Tong et al., Brown, and Thomas, that claims 17 and 18

are nonobvious in view of these references, and that claims 17 and 18 are separately patentable from the remaining claims.

12. The cited references, alone or in proper combination, do not render claim 19 unpatentable under 35 U.S.C. § 103(a).

Claim 19 is directed to the chassis of claim 1, wherein the chassis includes a common midfoot portion. P. 6, ll. 5-6. Appellant respectfully submits that at least this limitation of claim 19 clearly and patentably distinguishes the claimed invention over Giese et al., Tong et al., Brown, and Thomas, that claim 19 is nonobvious in view of these references, and that claim 19 is separately patentable from the remaining claims.

As discussed above in connection with independent claim 1, the proposed combination of Giese et al. and Tong et al. fails to render claim 1 obvious. Claim 19 depends directly from claim 1 and includes the limitations thereof. Consequently, Appellant respectfully submits that the additional limitations of claim 19 regarding the common midfoot portion further distinguishes Appellant's claimed invention over the references. The resulting combination of Giese et al., Tong et al., Brown, and Thomas as set forth in the Office Action fails to show or suggest at least the claimed limitations of the parent claims (e.g., the generally planar chassis) and this additional limitation of Appellant's claimed invention. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 19. *See, e.g., In re Wright* and *In re Nielson*.

Regarding the proposed combination of Giese et al., Brown, and Thomas, Appellant respectfully submits that, as discussed above, Thomas teaches away from both Giese et al. and Brown, meaning, per the rule of *In re Rudko*, Appellant's claim 19 is nonobvious.

Appellant respectfully submits that at least the common midfoot of claim 19 clearly and patentably distinguishes the claimed invention over Giese et al., Tong et al., Brown, and Thomas, that claim 19 is nonobvious in view of these references, and that claim 19 is separately patentable from the remaining claims.

13. The cited references, alone or in proper combination, do not render claim 20 unpatentable under 35 U.S.C. § 103(a).

Claim 20 is directed to a single piece generally planar polymeric chassis for an article of footwear. The claim requires a plurality of elongated elements and at least one space therebetween extending from the forwardmost extent of the forefoot portion to the midfoot portion. Appellant respectfully submits that at least these limitations of claim 20 clearly and patentably distinguish the claimed invention over Giese et al., Tong et al., Brown, and Thomas, that claim 20 is nonobvious in view of these references, and that claim 20 is separately patentable from the remaining claims.

The proposed combination of Giese et al. and Tong et al. as set forth in the Office Action fails to show or suggest at least the claimed limitations of the generally planar chassis. In contrast, the proposed combination results in a structure having an undulating or sinusoidal shape in cross section. Accordingly, a prima facie case of obviousness has not been established with respect to claim 20. *See, e.g., In re Wright and In re Nielson.*

Regarding the proposed combination of Giese et al., Brown, and Thomas, Appellant respectfully submits that, as discussed above, Thomas teaches away from both Giese et al. and Brown, meaning, per the rule of *In re Rudko*, Appellant's claim 20 is nonobvious.

Appellant respectfully submits that claim 20 clearly and patentably distinguishes the claimed invention over Giese et al., Tong et al., Brown, and Thomas, that claim 20 is nonobvious in view of these references, and that claim 20 is separately patentable from the remaining claims.

14. The cited references, alone or in proper combination, do not render claim 21 unpatentable under 35 U.S.C. § 103(a).

Claim 21 is directed to the chassis of claim 20, wherein the elongated elements are disposed adjacent one another. P. 6, ll. 10-11; p. 13, ll. 12-13. Appellant respectfully submits that at least this limitation of claim 21 clearly and patentably distinguishes the claimed invention over Giese et al., Tong et al., Brown, and Thomas, that claim 21 is nonobvious in view of these references, and that claim 21 is separately patentable from the remaining claims.

As discussed above in connection with independent claim 20, the proposed combination of Giese et al. and Tong et al. fails to render claim 20 obvious. Claim 21 depends directly from claim 20 and includes the limitations thereof. Consequently, Appellant respectfully submits that the additional limitations of claim 21 regarding the adjacent relationship between the elongated elements further distinguishes Appellant's claimed invention over the references. The resulting combination of Giese et al., Tong et al., Brown, and Thomas as set forth in the Office Action fails to show or suggest at least the claimed limitations of the parent claims (e.g., the generally planar chassis) and this additional limitation of Appellant's claimed invention. Accordingly, a prima facie case of obviousness has not been established with respect to claim 21. *See, e.g., In re Wright and In re Nielson.*

Regarding the proposed combination of Giese et al., Brown, and Thomas, Appellant respectfully submits that, as discussed above, Thomas teaches away from both Giese et al. and Brown, meaning, per the rule of *In re Rudko*, Appellant's claim 21 is nonobvious.

Appellant respectfully submits that at least the adjacently arranged elongated elements of claim 21 clearly and patentably distinguish the claimed invention over Giese et al., Tong et al., Brown, and Thomas, that claim 21 is nonobvious in view of these references, and that claim 21 is separately patentable from the remaining claims.

15. The cited references, alone or in proper combination, do not render claims 22 and 23 unpatentable under 35 U.S.C. § 103(a).

Claim 22 is directed to the chassis of claim 1, further comprising at least one lug extending from a bottom side of the chassis. P. 8, ll. 18-22. Claim 23 is directed to the chassis of claim 20, further comprising at least one lug extending from a bottom side of the chassis. *Id.* Appellant respectfully submits that at least the lug and lug extension limitations of claims 22 and 23 clearly and patentably distinguish the claimed invention over Giese et al., Tong et al., Brown, and Thomas, that claims 22 and 23 are nonobvious in view of these references, and that claims 22 and 23 are separately patentable from the remaining claims.

As discussed above in connection with independent claims 1 and 20, the proposed combination of Giese et al. and Tong et al. fails to render claims 1 and 20 obvious. Claim 22

depends directly from claim 1 and includes the limitations thereof. Claim 23 depends directly from claim 20 and includes the limitations thereof. Consequently, Appellant respectfully submits that the additional limitations of claims 22 and 23 regarding the lug further distinguish Appellant's claimed invention over the references. The resulting combination of Giese et al., Tong et al., Brown, and Thomas as set forth in the Office Action fails to show or suggest at least the claimed limitations of the parent claim (e.g., the generally planar chassis) and these additional limitations of Appellant's claimed invention. Accordingly, a prima facie case of obviousness has not been established with respect to claims 22 and 23. *See, e.g., In re Wright and In re Nielson.*

Regarding the proposed combination of Giese et al., Brown, and Thomas, Appellant respectfully submits that, as discussed above, Thomas teaches away from both Giese et al. and Brown, meaning, per the rule of *In re Rudko*, Appellant's claims 22 and 23 are nonobvious.

Appellant respectfully submits that claims 22 and 23 clearly and patentably distinguish the claimed invention over Giese et al., Tong et al., Brown, and Thomas, that claims 22 and 23 are nonobvious in view of these references, and that claims 22 and 23 are separately patentable from the remaining claims.

16. The cited references, alone or in proper combination, do not render claim 39 unpatentable under 35 U.S.C. § 103(a).

Claim 39 is directed to a generally planar polymeric chassis with at least three elongated elements with generally nonlinear spaces between them. Figure 4, RD 310, 314; p. 13, ll. 9-10; 12-13. The elongated elements extend from a lateral side to a medial side of the chassis, and extend substantially along an entire length of the chassis from a heel portion of the chassis to a toe portion of the chassis. Figure 4, p. 13, ll. 11-12. Appellant respectfully submits that at least these limitations of claim 39 clearly and patentably distinguish the claimed invention over Giese et al., Tong et al., Brown, and Thomas, that claim 39 is nonobvious in view of these references, and that claim 39 is separately patentable from the remaining claims.

The proposed combination of Giese et al. and Tong et al. as set forth in the Office Action fails to show or suggest at least the claimed limitations of the generally planar chassis. In contrast, the proposed combination results in a structure having an undulating or sinusoidal shape

in cross section. Accordingly, a prima facie case of obviousness has not been established with respect to claim 39. *See, e.g., In re Wright* and *In re Nielson*.

Regarding the proposed combination of Giese et al., Brown, and Thomas, Appellant respectfully submits that, as discussed above, Thomas teaches away from both Giese et al. and Brown, meaning, per the rule of *In re Rudko*, Appellant's claim 39 is nonobvious.

Appellant respectfully submits that claim 39 clearly and patentably distinguishes the claimed invention over Giese et al., Tong et al., Brown, and Thomas, that claim 39 is nonobvious in view of these references, and that claim 39 is separately patentable from the remaining claims.

VI. Claim 11 constitutes nonobvious subject matter and is patentable over Giese et al. (U.S. Pat. No. 5,572,805) in view of Tong et al. (U.S. Pat. No. 5,185,943) or Brown (U.S. Pat. No. D446,917) and Thomas (U.S. Pat. No. 444,735), and further in view of Kendall (U.S. Pat. No. 5,713,143).

A. The cited references, alone or in proper combination, do not render claim 11 obvious and unpatentable under 35 U.S.C. § 103(a).

In the Office Action, the Examiner rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Giese et al. in view of Tong et al. or Brown and Thomas, and further in view of Kendall. Office Action, p. 5.

1. U.S. Patent No. 5,713,143 to Kendall (issued Feb. 3, 1998).

Kendall discloses an orthotic system made from a compression resistant gel or foam. Kendall, col. 2, ll. 51-58. Components of the orthotic system include a partial insole that extends two-thirds the length of the foot, a heel cup 30, and a metatarsal pad 45. Figure 5. Also included are apertures 37, 46 for self-adjustment during use. Col. 7, ll. 11-16; 51-55. The system is purportedly effective in controlling pronation and supination, and for absorbing shock. Col 9, ll. 36-54.

The Office Action states that it would have been obvious to provide a side opening taught by Kendall in a chassis. Office Action, p. 5. It is unclear whether, in the instant ground of rejection, the Examiner has applied the proper standard of obviousness, because the Office Action does not refer to what would have been obvious to one of ordinary skill in the art at the time the invention was made.

2. The cited references, alone or in proper combination, do not render claim 11 unpatentable under 35 U.S.C. § 103(a).

Claim 11 is directed to the chassis of claim 10 wherein the chevron opens to one of the medial side or the lateral side of the chassis. P. 6, ll. 17-18. Appellant respectfully submits that at least this limitation of claim 11 clearly and patentably distinguishes the claimed invention over

Giese et al., Tong et al., Brown, Thomas, and Kendall, that claim 11 is nonobvious in view of these references, and that claim 11 is separately patentable from the remaining claims.

Claim 11 depends directly from claim 10 and indirectly from claims 1 and 9, and includes all of the limitations of each. As discussed above, the combination of Giese et al., Tong et al., Brown, and Thomas fails to render independent claim 1 obvious. To the extent any of these references disclose an opening in the rearfoot defined by two elements, the opening is not in the shape of Appellant's claimed chevron. Appellant's claimed opening has the specific shape and position necessary to provide cushioning in the heel and to permit cleat formation. P. 10, ll. 1-4. In contrast, the Kendall apertures 37, 46 clearly are not in the shape of a chevron. Kendall, Figure 5. Consequently, the proposed combination of Giese et al., Tong et al., Brown, Thomas, and Kendall fails to show the claimed limitations of the parent claims (e.g., the generally planar chassis and chevron shaped opening) and the additional limitation of Appellant's chevron shaped opening to the medial or lateral side of the chassis. Accordingly, a prima facie case of obviousness has not been established with respect to claim 11. *See, e.g., In re Wright and In re Nielson.*

Kendall is directed to an orthotic appliance for footwear, i.e., a mechanical device to support or supplement weakened or abnormal joints or limbs. As discussed above, Appellant's chassis is related to providing, for example, flexibility and effective power transfer. Specification, p. 1, ll. 1-2; p. 2, ll. 1-2. Consequently, the Kendall appliance and Appellant's chassis deal with different problems. Following the rule of *Lindemann*, Kendall cannot provide a basis for an obviousness rejection of Appellant's claimed invention, meaning the combination of references proposed by the Office Action does not support a prima facie case of obviousness of claim 11.

The structures in Giese et al., Tong et al., and Brown focus on power transfer. Kendall, in contrast, is concerned with footwear structures that serve rehabilitative purposes. In further contrast, Thomas is directed to a voltaic insert to impart a potential difference to the wearer's foot. Consequently, the Examiner has drawn together five references from at least three disparate areas in footwear technology. Appellant respectfully submits that a person of ordinary skill would not seek to combine references from such disparate areas. Using Appellant's claimed

invention as a template, the Examiner has pieced together the teachings of the prior art in an attempt to render Appellant's claimed invention obvious. Appellant respectfully submits that, by doing so, the Examiner has engaged in impermissible hindsight reconstruction. "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fritch*, 23 U.S.P.Q.2d (BNA) 1780, 1784 (Fed. Cir. 1992) (quoting *In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1600 (Fed. Cir. 1988)).

In view of the above, Appellant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness of claim 11. Appellant respectfully submits that claim 11 clearly and patentably distinguishes the claimed invention over Giese et al., Tong et al., Brown, Thomas, and Kendall, that claim 11 is nonobvious in view of these references, and that claim 11 is separately patentable from the remaining claims.

VII. Claims 26-30 and 35-38 constitute nonobvious subject matter and are patentable over Giese et al. (U.S. Pat. No. 5,572,805) in view of Tong et al. (U.S. Pat. No. 5,185,943) or Brown (U.S. Pat. No. D446,917) and Thomas (U.S. Pat. No. 444,735), and further in view of Crowley (U.S. Pat. No. 4,393,604).

A. The cited references, alone or in proper combination, do not render claims 26-30 and 35-38 obvious and unpatentable under 35 U.S.C. § 103(a).

In the Office Action, the Examiner rejected claims 26-30 and 35-38 under 35 U.S.C. § 103(a) as being unpatentable over Giese et al. in view of Tong et al. or Brown and Thomas, and further in view of Crowley. Office Action, p. 5.

The Office Action states that it would have been obvious to provide cleats taught by Crowley and use a transparent outer skin in a chassis. Office Action, pp. 5-6. It is unclear whether, in the instant ground of rejection, the Examiner has applied the proper standard of obviousness, because the Office Action does not refer to what would have been obvious to one of ordinary skill in the art at the time the invention was made.

1. The cited references, alone or in proper combination, do not render claim 26 unpatentable under 35 U.S.C. § 103(a).

Claim 26 is directed to an article of footwear that includes a sole with at least one cleat that is proximate to one or both of the lateral and medial sides of the article of footwear, and a generally planar polymeric chassis that extends substantially along an entire length of the heel and toe portions of the article of footwear. Appellant respectfully submits that at least these aspects of claim 26 clearly and patentably distinguish the claimed invention over Giese et al., Tong et al., Brown, Thomas, and Crowley, that claim 26 is nonobvious in view of these references, and that claim 26 is separately patentable from the remaining claims.

As an initial matter, Appellant respectfully submits that Thomas cannot be properly combined with Giese et al., Tong et al., and Brown, because Thomas teaches the use of separate metallic plates necessary to achieve the desired voltaic effect, in contrast to the other references that teach single component structures (i.e., the Giese et al. stabilizer 19, the Tong et al. insert member 56, 90, 120, and the Brown insert). Consequently, Thomas teaches away from Giese et al., Tong et al., and Brown.

Excluding Thomas from the proposed combination leaves the Giese et al., Tong et al., Brown, and Crowley references. As discussed above, the combination of Giese et al., Tong et al., and Brown results in a structure that has an undulating or sinusoidal shape in cross section, in contrast to Appellant's claimed generally planar chassis. Crowley is directed to lugs disposed on an outsole, and does not teach or suggest any chassis. Consequently, the combination of Crowley and the other references fails to show the claimed limitations, meaning a prima facie case of obviousness has not been established with respect to claim 26. *See, e.g., In re Wright and In re Nielson.*

To support the instant rejection, the Examiner has drawn together five different references. Namely, the Giese et al., Tong et al., and Brown references are directed to chassis designs for effective power transfer. Thomas is concerned with producing a voltaic effect to impart a potential difference to the foot of the wearer. Crowley focuses on a lug or cleat structure integrated with an outsole, not a chassis. Although all of these references are related to the extent that they broadly involve footwear technology, they represent at least three disparate areas of

innovation as described. Appellant respectfully submits that a person of ordinary skill would not seek to combine references from such disparate areas. As discussed above, there is no motivation to combine the references as set forth in the Office Action because the references teach away from one another and any such combination, if attempted, fails to show or suggest Appellant's claimed invention. In light of this, and the sheer number and disparity of the references used to support the instant rejection, Appellant respectfully submits that the Examiner has failed to consider Appellant's claimed invention as a whole and has engaged in impermissible hindsight reconstruction by relying on Appellant's disclosure as a template to piece together the teachings of the prior art in an attempt to render Appellant's claimed invention obvious. *In re Fritch*, 23 U.S.P.Q.2d (BNA) at 1784.

In view of the above, Appellant respectfully submits that claim 26 clearly and patentably distinguishes the claimed invention over Giese et al., Tong et al., Brown, Thomas, and Crowley, that claim 26 is nonobvious in view of these references, and that claim 26 is separately patentable from the remaining claims.

2. The cited references, alone or in proper combination, do not render claims 27 and 28 unpatentable under 35 U.S.C. § 103(a).

Claim 27 is directed to the article of footwear of claim 26, wherein the chassis includes an elongated element extending toward a toe portion from a midfoot portion, and an elongated element extending toward a heel portion from the midfoot portion. Figure 3A. Claim 28 is directed to the article of footwear of claim 26, wherein the chassis includes a plurality of elongated elements extending generally from a heel portion to a toe portion. *Id.* Appellant respectfully submits that at least the elongated element limitations of claims 27 and 28 clearly and patentably distinguish the claimed invention over Giese et al., Tong et al., Brown, Thomas, and Crowley, that claims 27 and 28 are nonobvious in view of these references, and that claims 27 and 28 are separately patentable from the remaining claims.

As discussed above in connection with independent claim 26, Thomas may not be properly combined with Giese et al., Tong et al., Brown, and Crowley, and these last four references fail to render claim 26 obvious. Claims 27 and 28 depend directly from claim 26 and

include the limitations thereof. Consequently, Appellant respectfully submits that the additional limitations of an elongated element in the forefoot and rearfoot portions (claim 27) or a plurality of elongated elements extending generally from the heel to toe portion (claim 28) further distinguish Appellant's claimed invention over the references. The resulting combination of references set forth in the Office Action fails to show or suggest at least the claimed limitations of the parent claim (e.g., the generally planar chassis) and these additional limitations of Appellant's claimed invention. Accordingly, a prima facie case of obviousness has not been established with respect to claims 27 and 28. *See, e.g., In re Wright and In re Nielson.*

Further, and as discussed above in connection with claim 26, there is no motivation for a person of ordinary skill to combine the five different references (representing at least three disparate areas of innovation) as set forth in the Office Action to support the instant rejection. Appellant respectfully submits that the Examiner has failed to consider Appellant's claimed invention as a whole and has engaged in impermissible hindsight reconstruction by relying on Appellant's disclosure as a template to piece together the teachings of the prior art in an attempt to render Appellant's claimed invention obvious. *In re Fritch*, 23 U.S.P.Q.2d (BNA) at 1784.

Appellant respectfully submits that at least the elongated elements of claims 27 and 28 clearly and patentably distinguish the claimed invention over Giese et al., Tong et al., Brown, Thomas, and Crowley, that claims 27 and 28 are nonobvious in view of these references, and that claims 27 and 28 are separately patentable from the remaining claims.

3. The cited references, alone or in proper combination, do not render claim 29 unpatentable under 35 U.S.C. § 103(a).

Claim 29 is directed to the article of footwear of claim 26, wherein the sole is an outsole. P. 4, ll. 9-10. Appellant respectfully submits that at least this aspect of claim 29 clearly and patentably distinguishes the claimed invention over Giese et al., Tong et al., Brown, Thomas, and Crowley, that claim 29 is nonobvious in view of these references, and that claim 29 is separately patentable from the remaining claims.

As discussed above in connection with independent claim 26, Thomas may not be properly combined with Giese et al., Tong et al., Brown, and Crowley, and these last four

references fail to render claim 26 obvious. Claim 29 depends directly from claim 26 and includes the limitations thereof. Consequently, Appellant respectfully submits that the additional limitation of an outsole further distinguishes Appellant's claimed invention over the references. The resulting combination of references set forth in the Office Action fails to show or suggest at least the claimed limitations of the parent claim (e.g., the generally planar chassis) and this additional limitation of Appellant's claimed invention. Accordingly, a prima facie case of obviousness has not been established with respect to claim 29. *See, e.g., In re Wright* and *In re Nielson*.

Further, and as discussed above in connection with claim 26, there is no motivation for a person of ordinary skill to combine the five different references (representing at least three disparate areas of innovation) as set forth in the Office Action to support the instant rejection. Appellant respectfully submits that the Examiner has failed to consider Appellant's claimed invention as a whole and has engaged in impermissible hindsight reconstruction by relying on Appellant's disclosure as a template to piece together the teachings of the prior art in an attempt to render Appellant's claimed invention obvious. *In re Fritch*, 23 U.S.P.Q.2d (BNA) at 1784.

Appellant respectfully submits that at least the outsole limitation of claim 29 clearly and patentably distinguishes the claimed invention over Giese et al., Tong et al., Brown, Thomas, and Crowley, that claim 29 is nonobvious in view of these references, and that claim 29 is separately patentable from the remaining claims.

4. The cited references, alone or in proper combination, do not render claim 30 unpatentable under 35 U.S.C. § 103(a).

Claim 30 is directed to the article of footwear of claim 26, where a lug extends from the bottom side of the chassis. Figure 3A, RD 230; p. 10, ll. 18-19. Appellant respectfully submits that at least the lug limitation of claim 30 clearly and patentably distinguishes the claimed invention over Giese et al., Tong et al., Brown, Thomas, and Crowley, that claim 30 is nonobvious in view of these references, and that claim 30 is separately patentable from the remaining claims.

As discussed above in connection with independent claim 26, Thomas may not be properly combined with Giese et al., Tong et al., Brown, and Crowley, and these last four references fail to render claim 26 obvious. Claim 30 depends directly from claim 26 and includes the limitations thereof. Consequently, Appellant respectfully submits that the additional limitation of a lug extending from the chassis further distinguishes Appellant's claimed invention over the references. The resulting combination of references set forth in the Office Action fails to show or suggest at least the claimed limitations of the parent claim (e.g., the generally planar chassis) and this additional limitation of Appellant's claimed invention. Accordingly, a prima facie case of obviousness has not been established with respect to claim 30. *See, e.g., In re Wright* and *In re Nielson*.

Further, and as discussed above in connection with claim 26, there is no motivation for a person of ordinary skill to combine the five different references (representing at least three disparate areas of innovation) as set forth in the Office Action to support the instant rejection. Appellant respectfully submits that the Examiner has failed to consider Appellant's claimed invention as a whole and has engaged in impermissible hindsight reconstruction by relying on Appellant's disclosure as a template to piece together the teachings of the prior art in an attempt to render Appellant's claimed invention obvious. *In re Fritch*, 23 U.S.P.Q.2d (BNA) at 1784.

Appellant respectfully submits that at least the lug and projection limitations of claim 30 clearly and patentably distinguishes the claimed invention over Giese et al., Tong et al., Brown, Thomas, and Crowley, that claim 30 is nonobvious in view of these references, and that claim 30 is separately patentable from the remaining claims.

5. The cited references, alone or in proper combination, do not render claim 35 unpatentable under 35 U.S.C. § 103(a).

Claim 35 is directed to the article of footwear of claim 26 wherein the polymeric chassis is integrally formed with a skin. Figure 3A, RD 201; p. 11, ll. 14-15. Appellant respectfully submits that at least this aspect of claim 35 clearly and patentably distinguishes the claimed invention over Giese et al., Tong et al., Brown, Thomas, and Crowley, that claim 35 is

nonobvious in view of these references, and that claim 35 is separately patentable from the remaining claims.

As discussed above in connection with independent claim 26, Thomas may not be properly combined with Giese et al., Tong et al., Brown, and Crowley, and these last four references fail to render claim 26 obvious. Claim 35 depends directly from claim 26 and includes the limitations thereof. Consequently, Appellant respectfully submits that the additional limitation of the chassis integrally formed with a skin further distinguishes Appellant's claimed invention over the references. The resulting combination of references set forth in the Office Action fails to show or suggest at least the claimed limitations of the parent claim (e.g., the generally planar chassis) and this additional limitation of Appellant's claimed invention. Accordingly, a prima facie case of obviousness has not been established with respect to claim 35. *See, e.g., In re Wright and In re Nielson.*

Further, and as discussed above in connection with claim 26, there is no motivation for a person of ordinary skill to combine the five different references (representing at least three disparate areas of innovation) as set forth in the Office Action to support the instant rejection. Appellant respectfully submits that the Examiner has failed to consider Appellant's claimed invention as a whole and has engaged in impermissible hindsight reconstruction by relying on Appellant's disclosure as a template to piece together the teachings of the prior art in an attempt to render Appellant's claimed invention obvious. *In re Fritch*, 23 U.S.P.Q.2d (BNA) at 1784.

Appellant respectfully submits that at least the integrally formed skin limitation of claim 35 clearly and patentably distinguishes the claimed invention over Giese et al., Tong et al., Brown, Thomas, and Crowley, that claim 35 is nonobvious in view of these references, and that claims 30 and 31 are separately patentable from the remaining claims.

6. The cited references, alone or in proper combination, do not render claims 36-38 unpatentable under 35 U.S.C. § 103(a).

Claim 36 is directed to the article of footwear of claim 35 further comprising an externally visible intermediate layer of material between the integrally formed chassis and skin. Figure 3B, RD 203, p. 12, ll. 8-11; 14-16. Claim 37 is directed to the article of footwear of claim

36, wherein the intermediate layer of material is a film. P. 12, ll. 8-11. Claim 38 is directed to the article of footwear of claim 37, wherein the film comprises one of a design, a color, and a combination of a design and a color. P. 12, ll. 14-15. Appellant respectfully submits that at least these limitations of claims 36-38 clearly and patentably distinguish the claimed invention over Giese et al., Tong et al., Brown, Thomas, and Crowley, that claims 36-38 are nonobvious in view of these references, and that claims 36-38 are separately patentable from the remaining claims.

As discussed above in connection with independent claim 26, Thomas may not be properly combined with Giese et al., Tong et al., Brown, and Crowley, and these last four references fail to render claim 26 obvious. Claim 36 depends directly from claim 35 and indirectly from claim 26, and includes all of the limitations of each. Claim 37 depends directly from claim 36 and indirectly from claims 26 and 35, and includes all of the limitations of each. Claim 38 depends directly from claim 37 and indirectly from claims 26, 35, and 36, and includes all of the limitations of each. Consequently, Appellant respectfully submits that the additional limitations of an externally visible intermediate layer (claim 36), intermediate film layer (claim 37), and film design and color (claim 38) further distinguish Appellant's claimed invention over the references. The resulting combination of references set forth in the Office Action fails to show or suggest at least the claimed limitations of the parent claim (e.g., the generally planar chassis) and these additional limitations of Appellant's claimed invention. Accordingly, a prima facie case of obviousness has not been established with respect to claims 36-38. *See, e.g., In re Wright and In re Nielson.*

Further, and as discussed above in connection with claim 26, there is no motivation for a person of ordinary skill to combine the five different references (representing at least three disparate areas of innovation) as set forth in the Office Action to support the instant rejection. Appellant respectfully submits that the Examiner has failed to consider Appellant's claimed invention as a whole and has engaged in impermissible hindsight reconstruction by relying on Appellant's disclosure as a template to piece together the teachings of the prior art in an attempt to render Appellant's claimed invention obvious. *In re Fritch*, 23 U.S.P.Q.2d (BNA) at 1784.

Appellant respectfully submits that claims 36-38 clearly and patentably distinguish the claimed invention over Giese et al., Tong et al., Brown, Thomas, and Crowley, that claims 36-38

are nonobvious in view of these references, and that claims 36-38 are separately patentable from the remaining claims.

VIII. Claims 30 and 31 constitute nonobvious subject matter and are patentable over Giese et al. (U.S. Pat. No. 5,572,805) in view of Tong et al. (U.S. Pat. No. 5,185,943) or Brown (U.S. Pat. No. D446,917) and Thomas (U.S. Pat. No. 444,735), further in view of Crowley (U.S. Pat. No. 4,393,604), and further in view of Cameron (U.S. Pat. No. 3,739,497) or Barre et al. (U.S. Pat. No. 5,473,827).

A. The cited references, alone or in proper combination, do not render claims 30 and 31 obvious and unpatentable under 35 U.S.C. § 103(a).

In the Office Action, the Examiner rejected claims 30 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Giese et al. in view of Tong et al. or Brown and Thomas, further in view of Crowley, and further in view of Cameron or Barre et al. Office Action, p. 6.

1. U.S. Patent No. 3,739,497 to Cameron (issued June 19, 1973).

Cameron discloses a cleated traction means 16 that allows rotation. Cameron, col. 2, ll. 3-6. The structure includes a series of plates, sealing rings, and clamping rings. Cameron, Figure 5. An outer plate 22 includes integrally molded cleats 24, and this plate 24 connects to an inner carrier plate 30 using mounting screws 44. Col. 2, ll. 28-31. The mounting screws 44 mate with receptacles 32 on the inner carrier plate. *Id.*

2. U.S. Patent No. 5,473,827 to Barre et al. (issued Dec. 12, 1995).

Barre et al. discloses an outsole with molded projections, referred to as studs 11. Barre et al., col. 1, ll. 9-11; col. 4, ll. 7-11. Stiffening plates 2, 3 and a reinforcing plate 4 are affixed to the outsole and allow various stud configurations. Col. 3, ll. 28-36; col. 4, ll. 40-43. A hard core 23 of outsole material 1 may project into the studs 11. Col. 3, l. 63 – col. 6, l. 2.

The Office Action states that it would have been obvious to provide lugs that extend into cleats taught by Cameron or Barre et al. in a chassis. Office Action, p. 6. It is unclear whether, in the instant ground of rejection, the Examiner has applied the proper standard of obviousness,

because the Office Action does not refer to what would have been obvious to one of ordinary skill in the art at the time the invention was made.

3. The cited references, alone or in proper combination, do not render claims 30 and 31 unpatentable under 35 U.S.C. § 103(a).

Claim 30 is directed to the article of footwear of claim 26, where a lug extends from the bottom side of the chassis. Figure 3A, RD 230; p. 10, ll. 18-19. Claim 31 is directed to the article of footwear of claim 30, wherein the lug projects into the cleat. Figure 3A, RD 230, 232; p. 10, ll. 19-20. Appellant respectfully submits that at least the lug and projection limitations of claims 30 and 31, respectively, clearly and patentably distinguish the claimed invention over Giese et al., Tong et al., Brown, Thomas, Crowley, Cameron, and Barre et al., that claims 30 and 31 are nonobvious in view of these references, and that claims 30 and 31 are separately patentable from the remaining claims.

As discussed above in connection with independent claim 26, Thomas may not be properly combined with Giese et al., Tong et al., Brown, and Crowley, and these last four references fail to render claim 26 obvious. Claim 30 depends directly from claim 26 and includes the limitations thereof. Claim 31 depends directly from claim 30 and indirectly from claim 26, and includes all of the limitation of each. Consequently, Appellant respectfully submits that the additional limitations of a lug extending from the chassis (claim 30) or lug projecting into the cleat (claim 31) further distinguish Appellant's claimed invention over the references. The resulting combination of references set forth in the Office Action fails to show or suggest at least the claimed limitations of the parent claim (e.g., the generally planar chassis) and these additional limitations of Appellant's claimed invention. Accordingly, a prima facie case of obviousness has not been established with respect to claims 30 and 31. *See, e.g., In re Wright and In re Nielson.*

Further, claim 30 requires that the lug extend from the bottom side of the chassis. Barre et al. neither teaches nor suggests any lug-type structure that projects from a chassis, rather, Barre et al. teaches projections from an outsole. As discussed above, Appellant's chassis is distinguishable from an outsole. Similarly, the Cameron projections are part of a structure

attached to the outer sole 12 of the shoe; they are not a component of any chassis. Cameron, Figure 5. Appellant respectfully submits that, by asserting that the Barre et al. and Cameron references teach providing lugs on a chassis, the Office Action misconstrues these references. Office Action, p. 6. Consequently, Barre et al. and Cameron fail to teach or suggest the additional limitations of Appellant's claim 30.

With respect to claim 31, Barre et al. teaches an outsole configuration that includes a series of plates with studs affixed to the outsole, with outsole material projecting into the studs. Since Barre et al. fails to teach or suggest a lug extending from a chassis, Barre et al. cannot teach or suggest that the lug extends from the chassis into a cleat, with chassis material projecting into the cleat. Cameron also fails to teach or suggest Appellant's claimed projection of a lug into a cleat. The Office Action incorrectly states that the Cameron "lug 32" extends into the Cameron "cleat 24." Office Action, p. 6. In actuality, screws 44, which are set apart from cleats 24, mate with the Cameron receptacles 32. Cameron, col. 2, ll. 28-36. This is to ensure that, if the Cameron cleats 24 are broken from their mounts, there are no underlying projections remaining to cause injuries. Col. 2, ll. 48-54. In other words, the receptacles 32 do not project into the cleats 24, as the Office Action asserts. Accordingly, Cameron cannot be relied on to support an obviousness rejection for at least Appellant's claimed lug-cleat configuration.

The Examiner has set forth a combination of seven different references to support the instant obviousness rejection. As discussed above in connection with claim 26, there is no motivation for a person of ordinary skill to combine the first five different references (representing at least three disparate areas of innovation). Like Crowley, the two references added in the instant rejection, Cameron, and Barre et al., are concerned with lug and cleat structure and may be considered part of the same disparate area of innovation as Crowley. Following the reasoning outlined above, then, there is no motivation for a person of ordinary skill to combine these seven different references. In view of this, and the sheer number and disparity of references relied on by the Examiner, Appellant respectfully submits that the Examiner has failed to consider Appellant's claimed invention as a whole and has engaged in impermissible hindsight reconstruction by relying on Appellant's disclosure as a template to piece together the

teachings of the prior art in an attempt to render Appellant's claimed invention obvious. *In re Fritch*, 23 U.S.P.Q.2d (BNA) at 1784.

In view of the above, Appellant respectfully submits that at least the lug and projection limitations of claims 30 and 31 clearly and patentably distinguish the claimed invention over Giese et al., Tong et al., Brown, Thomas, Crowley, Cameron, and Barre et al., that claims 30 and 31 are nonobvious in view of these references, and that claims 30 and 31 are separately patentable from the remaining claims.

IX. The other references cited, but not relied on, by the Examiner neither anticipate nor render obvious Appellant's claims.

The Examiner has cited the following references but is not, or is no longer, relying on them to support rejections. Appellant respectfully submits that each of these references, as described below in brief, neither anticipates nor, alone or in proper combination, renders obvious Appellant's claimed invention.

1. U.S. Patent No. 1,484,785 to Hiss (issued Feb. 26, 1924).

Hiss discloses an arch supporting appliance 1 that, in side view, has a substantially serpentine profile. Hiss, Figure 2. This facilitates the installation of the supporting appliance 1 between the inner sole 8 and outer sole 11 of the shoe, allowing the supporting appliance 1 to follow the heel-to-toe contour. Figure 7. Further, and as shown in Figures 4 and 5, the shank portion 4 of the arch supporting appliance 1 is asymmetric. This purportedly avoids support of the inner longitudinal arc. Hiss, claims 1-4. Hiss neither teaches nor suggests a generally planar chassis.

2. U.S. Patent No. 1,923,365 to Gaines (issued Aug. 22, 1933).

Gaines discloses a baseball shoe with plates 5, 10 in the toe and heel areas. Gaines, Figures 4, 5. Attached to the heel plate 10 is an arch plate 13 for supporting the arch of the wearer's foot. Figure 4. Cleats are attached to the plates 5, 10. P. 2, ll. 97-100. Gaines neither teaches nor suggests a chassis with elongated elements having the claimed configuration (e.g., extent).

3. U.S. Patent No. 2,049,598 to Tubbs (issued Aug. 4, 1936).

Tubbs discloses an encapsulated plate placed between the inner and an outer sole of a shoe. Tubbs, p. 1, ll. 43-53. The encapsulation purportedly creates a moisture proof structure. *Id.* Tubbs neither teaches nor suggests (i) a chassis with elongated elements having the claimed configuration (e.g., extent), and (ii) one or more cleats or lugs.

4. U.S. Patent No. 3,204,347 to Snow (issued Sept. 7, 1965).

Snow discloses a sole plate for the attachment of spikes or cleats. Snow, col. 1, ll. 7-11. Portions of the sole plate project through the outer sole to receive the spikes or cleats. Snow, Figure 1. Snow neither teaches nor suggests a chassis with elongated elements having the claimed configuration (e.g., extent).

5. U.S. Patent No. 3,237,323 to MacNeill (issued Mar. 1, 1966).

MacNeill discloses anchor plates for golf shoes. Cleats or spikes are attached to the anchor plates. MacNeill neither teaches nor suggests a chassis with elongated elements having the claimed configuration (e.g., extent).

6. U.S. Patent No. 3,492,744 to Bernier et al. (issued Feb. 3, 1970).

Bernier et al. discloses a golf shoe with a composite bottom having cleats. Bernier et al., col. 1, ll. 52-54. The cleats are placed in the forefoot and heel areas. Col. 3, ll. 18-23. Bernier et al. neither teaches nor suggests a chassis with elongated elements having the claimed configuration (e.g., extent).

7. U.S. Patent No. 3,529,370 to Bernier et al. (issued Sept. 22, 1970).

Bernier et al. discloses anchor plates for the forefoot and heel areas of a golf shoe. Bernier et al., col. 1, ll. 31-33. Metal cleats are attached to the anchor plates. *Id.* Bernier et al. neither teaches nor suggests a chassis with elongated elements having the claimed configuration (e.g., extent).

8. U.S. Patent No. 3,685,175 to Granger, Jr. (issued Aug. 22, 1972).

Granger, Jr. discloses a cleat and cleat support system for golf shoes. Granger, Jr., col. 1, ll. 25-28. Cleats are located in the forefoot and heel areas. Granger, Jr., Figure 2. Granger, Jr. neither teaches nor suggests a chassis with elongated elements having the claimed configuration (e.g., extent).

9. U.S. Patent No. 4,085,526 to Hemmer (issued Apr. 25, 1978).

Hemmer discloses inner and outer sole structures with cleats projecting from the inner through the outer sole. Hemmer, Abstract. Hemmer neither teaches nor suggests a chassis with elongated elements having the claimed configuration (e.g., extent).

10. U.S. Patent No. 4,864,739 to Maestri (issued Sep. 12, 1989).

Maestri discloses an inner sole for a boot that includes two separate support zones. Maestri, col. 1, ll. 43-46. Maestri neither teaches nor suggests (i) a chassis with elongated elements having the claimed configuration (e.g., extent), and (ii) one or more cleats or lugs.

11. U.S. Patent No. 5,647,145 to Russell et al. (issued July 15, 1997).

Russell et al. discloses a sole structure that includes compressible material and support pads to cushion the wearer's foot. Russell et al., col. 1, l. 63 – col. 2, l. 12. The sole includes slots to redirect applied forces. Russell et al. neither teaches nor suggests (i) a chassis with elongated elements having the claimed configuration (e.g., extent), and (ii) one or more cleats or lugs.

12. U.S. Patent No. 5,850,702 to Okajima (issued Dec. 22, 1998).

Okajima discloses a snowboard boot sole having a sole core member 1 that is divided into left 1L, middle 1M, and right 1R portions. Okajima, col. 4, ll. 33-36. As depicted in Okajima Figure 7, there are linear spaces extending the length of the sole between the middle 1M and left 1L portions, and between the middle 1M and right 1R portions (near reference designators 6R and 6L, respectively). A cleat is also attached to the middle portion 1M. Col. 4, ll. 13-16. Okajima neither discloses nor suggests placement of a cleat proximate to at least one of the lateral and medial sides of the article of footwear. Further, Okajima neither discloses nor suggests generally nonlinear spaces between the middle 1M and left 1L portions, and between the middle 1M and right 1R portions, of the sole core member 1.

13. U.S. Patent No. 5,915,820 to Kraeuter et al. (issued June 29, 1999).

Kraeuter et al. discloses a structural chassis 52 for a shoe that accommodates flexing of a wearer's foot about forward and lateral push-off axes. Kraeuter et al., col. 5, ll. 29-32; col. 6, ll. 7-9. A transverse notch 62 in the chassis 52 influences the flexibility along the forward axis. Col. 6, ll. 39-41. Similarly, notches 64, 66 influence the flexibility along the lateral push-off axis. Col. 6, ll. 49-51. Notches 68 in the toe portion, as well as notches 56, 58 in the base of the arch support flange 54, permit additional flexibility about their respective positions. Col. 6, ll. 28-32, 66-67. As seen in Kraeuter et al. Figure 5, the notches 56, 58, 64, 66, 68 extend inward from an edge of the chassis 52. Kraeuter et al. neither teaches nor suggests (i) a chassis with elongated elements having the claimed configuration (e.g., extent), and (ii) one or more cleats or lugs.

14. U.S. Patent No. 5,987,783 to Allen et al. (issued Nov. 23, 1999).

Allen et al. discloses a system of receptacles used in a golf shoe. Allen et al., col. 2, ll. 27-32. The receptacles receive spikes or cleats and provide a support base. *Id.* Allen et al. neither teaches nor suggests a chassis with elongated elements having the claimed configuration (e.g., extent).

15. U.S. Patent No. 6,016,615 to Day (issued Jan. 25, 2000).

Day discloses a shoe sole having a moveable plate, channel, and ports to facilitate the attachment of spike or cleat. Day, col. 2, ll. 3-8. Day a chassis with elongated elements having the claimed configuration (e.g., extent).

16. U.S. Patent No. 6,199,303 to Luthi et al. (issued Mar. 13, 2001).

Luthi et al. discloses a stability element 10 for an article of footwear 1. Luthi et al., col. 2, ll. 39-46. A purpose of the stability element 10 is to control the rotation of the forefoot 13 relative to the rearfoot 12. *Id.* Luthi et al. neither teaches nor suggests (i) a chassis with elongated elements having the claimed configuration (e.g., extent), and (ii) one or more cleats or lugs.

17. U.S. Patent No. D410,965 to Schuette et al. (issued June 15, 1999).

Schuette et al. discloses an ornamental design for part of a shoe sole. Schuette et al., Figure 1. Schuette et al. neither teaches nor suggests (i) a chassis with elongated elements having the claimed configuration (e.g., extent), and (ii) one or more cleats or lugs.

18. WO Publication No. 98/20763 to Hockerson (published May 22, 1998).

Hockerson discloses a cleat frame 22 with a narrowed forefoot part 64. Hockerson, Figure 6. The cleat frame 22 is used in conjunction with the sole 20 in forming the shoe 18. Examination of Hockerson Figures 2, 6, and 7 shows that, in the forefoot part 64, the cleat frame narrows rapidly just forward of cleat supports 46, 48. Consequently, a significant portion of the forefoot region of the cleat frame 22 does not extend to the medial and lateral sides of the shoe 18. Hockerson neither teaches nor suggests) a chassis with elongated elements having the claimed configuration (e.g., extent).

CONCLUSION

Appellant respectfully submits that claims 1, 4-23, 26-31, and 35-39 are patentable in view of the cited references. Appellant urges the Board of Patent Appeals and Interferences to reverse the Examiner's rejections of these claims.

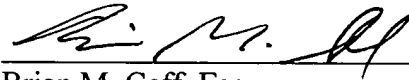
Date: September 22, 2003
Reg. No. 44,691

Tel. No.: (617) 310-8085
Fax No.: (617) 790-0332

Email: gaff@tht.com

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Respectfully submitted,



Brian M. Gaff, Esq.
Attorney for Appellant
Testa, Hurwitz, & Thibault, LLP
High Street Tower
125 High Street
Boston, Massachusetts 02110
www.tht.com

APPENDIX

1. A single piece generally planar polymeric chassis for installation in an article of footwear, the chassis comprising:
 - a medial side;
 - a lateral side;
 - a midfoot portion;
 - a forefoot portion, including a plurality of elongated elements that extend from the lateral side to the medial side, and from the midfoot portion into substantially an entire length of the forefoot portion, the plurality of elongated elements defining at least one space therebetween extending from a forwardmost extent of the forefoot portion and terminating in the midfoot portion; and
 - a rearfoot portion, including at least one elongated element that extends from the midfoot portion into substantially an entire length of a heel portion of the chassis.
2. (Cancelled)
3. (Cancelled)
4. The chassis of claim 1, wherein the forefoot portion comprises three elongated elements.
5. The chassis of claim 1, wherein at least one elongated element comprises at least one indentation along a width of the chassis.
6. The chassis of claim 1, wherein the rearfoot portion comprises two elongated elements.

7. The chassis of claim 4, wherein the forefoot portion elongated elements are disposed adjacent one another.
8. The chassis of claim 6, wherein the rearfoot portion elongated elements are disposed adjacent one another.
9. The chassis of claim 1, wherein the rearfoot portion comprises two elements defining an opening therebetween.
10. The chassis of claim 9, wherein the opening is in a form of a chevron.
11. The chassis of claim 10, wherein the chevron opens to one of the medial side or the lateral side of the chassis.
12. The chassis of claim 1, wherein a thickness of a first portion of the chassis is different than a thickness of a second portion of the chassis.
13. The chassis of claim 12, wherein the first portion of the chassis comprises the forefoot portion and the second portion comprises the rearfoot portion.
14. The chassis of claim 12, wherein the first portion of the chassis comprises a first elongated element and the second portion comprises a second elongated element.
15. The chassis of claim 12, wherein the first portion of the chassis comprises the midfoot portion and the second portion comprises the forefoot portion.
16. The chassis of claim 12, wherein the chassis comprises more than two portions, each comprising a different thickness.
17. The chassis of claim 1, wherein a first portion of the chassis comprises a material with properties different than a material of a second portion of the chassis.
18. The chassis of claim 17, wherein the chassis comprises more than two portions, each comprising different material properties.

19. The chassis of claim 1, wherein the chassis further comprises a common midfoot portion.
20. A single piece generally planar polymeric chassis for installation in an article of footwear, the chassis comprising a plurality of elongated elements that extend from a lateral side to a medial side of the chassis and extend substantially along an entire length from a heel portion of the chassis to a toe portion of the chassis, each elongated element comprising:
- a midfoot portion;
 - a forefoot portion; and
 - a rearfoot portion;
- wherein the plurality of elongated elements define at least one space therebetween extending from a forwardmost extent of the forefoot portion of the plurality of elongated elements and terminating in the midfoot portion.
21. The chassis of claim 20, wherein the elongated elements are disposed adjacent one another.
22. The chassis of claim 1, further comprising at least one lug extending from a bottom side of the chassis.
23. The chassis of claim 20, further comprising at least one lug extending from a bottom side of the chassis.
24. (Cancelled)
25. (Cancelled)
26. An article of footwear including a sole with at least one cleat, the sole comprising a generally planar polymeric chassis, wherein a forefoot portion of the chassis has a lateral side and a medial side, the lateral and medial sides being proximate to

corresponding lateral and medial sides of the article of footwear, the chassis extending substantially along an entire length of (i) a heel portion of the article of footwear, and (ii) a toe portion of the article of footwear, and wherein the cleat is proximate to at least one of the lateral and medial sides of the article of footwear.

27. The article of footwear of claim 26, wherein the chassis comprises:

a midfoot portion;

a forefoot portion, including at least one elongated element extending toward a toe portion from the midfoot portion; and

a rearfoot portion, including at least one elongated element extending toward a heel portion from the midfoot portion.

28. The article of footwear of claim 26, wherein the chassis comprises a plurality of elongated elements extending generally from a heel portion to a toe portion, each elongated element comprising:

a midfoot portion;

a forefoot portion; and

a rearfoot portion.

29. The article of footwear of claim 26, wherein the sole is an outsole.

30. The article of footwear of claim 26, wherein the chassis further comprises at least one lug extending from a bottom side of the chassis.

31. The article of footwear of claim 30, wherein the at least one lug projects into the cleat.

32. (Cancelled)

33. (Cancelled)

34. (Cancelled)

35. The article of footwear of claim 26 wherein the polymeric chassis is integrally formed with a skin.

36. The article of footwear of claim 35 further comprising an externally visible intermediate layer of material between the integrally formed chassis and skin.

37. The article of footwear of claim 36, wherein the intermediate layer of material is a film.

38. The article of footwear of claim 37, wherein the film comprises one of a design, a color, and a combination of a design and a color.

39. A generally planar polymeric chassis for installation in an article of footwear, the chassis comprising at least three elongated elements with generally nonlinear spaces formed therebetween, the elongated elements extending from a lateral side to a medial side of the chassis and extending substantially along an entire length of the chassis from a heel portion of the chassis to a toe portion of the chassis, each elongated element comprising:

a midfoot portion;

a forefoot portion; and

a rearfoot portion.